

102. (New) The method of claim 101, wherein said first signal and said second signal are received in a multichannel cable transmission.

103. (New) The method of claim 24, wherein said television program and said third information are included in first and second channels, respectively, of a multichannel cable transmission.

104. (New) The apparatus of claim 74, wherein said television program and said third information are included in first and second channels, respectively, of a multichannel cable transmission.

II. REMARKS

A. Overview Of Claims As Amended

The claims of the present application are directed generally to methods and apparatus for generating and outputting multimedia presentations. Independent claims 2, 20, 24, 26, 29, and 33 are directed to methods for outputting a multimedia presentation at a receiver station. Independent claims 37, 70, 74, 76, 85 and 95 are directed to apparatus that are generally analogous to the methods claimed in independent claims 2, 20, 24, 26, 29, and 33.

In claim 2, a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium.

In claim 20, a multimedia presentation is output through the coordination of a presentation of a first medium and information based on a second medium, whereby the content of the first and second media are identified.

In claim 24, a multimedia presentation of a television program and a second medium is output, whereby information stored at a receiver station is compared to content of a television program to determine whether to present the second medium based on information received from a source different from that of the television program.

In claim 26, a multimedia presentation of information included in one medium and information based on another medium is output, where content of each of the two media is identified and where one of the media is received from a remote transmitter station and the other medium is received from a different source.

In claim 29, a multimedia presentation of a first medium and a video image is output through processing a control signal at a receiver station which causes execution of processor instructions to create a series of discrete video images, whereby a video image of the series of discrete images is caused to be output after the identification of the first medium.

In claim 33, a multimedia presentation of information included in a first signal received from a remote transmitter station and information included in a second signal is output, whereby a user response is compared to information corresponding to content of the first signal in order to tune the receiver station to receive the second signal.

Claim 37 is an apparatus claim, which generally corresponds to method claim 2. Similarly, new claims 70, 74, 76, 85 and 95 are all new independent apparatus claims that generally correspond to method claims 20, 24, 26, 29, and 33, respectively. The remaining new claims (claims 67-69, 71-73, 75, 77-84, 86-94, 96-104) are all dependent claims. Applicants' proposed amendments to each independent claim and claims depending therefrom are discussed in detail below.

1. Independent Claim 2 And Claims Depending Therefrom

In claim 2, a plurality of signals, which include at least two media, are received at a receiver station and a multimedia presentation is output. Claim 2 has been amended to clarify that information from the first of the two media is stored. Further, the recitation whereby the first medium was stored to provide a first portion of the multimedia presentation has been deleted to conform to this amendment. The coordinating step of claim 2 has been similarly amended to specify that the coordinated presentation uses the information from the first of the two media, rather than the first portion of the multimedia presentation. The outputting step was similarly amended to reflect this change. Finally, claim 2 has also been amended to replace the viewer or listener with a user at the receiver station.

Dependent claims 3 and 7 have been amended to conform to the amendments made to claim 2 from which they depend.

Dependent claim 6 is amended to delete unnecessary recitations.

Dependent claim 8 is amended to delete unnecessary recitations.

Dependent claim 9 is amended to delete unnecessary recitations and further specify that the determining step causes a tuner at the receiver station to communicate the audio to an audio output device.

Dependent claim 10 is amended to delete unnecessary recitations.

Dependent claim 12 has been amended to conform to the amendments made to claim 2 from which it depends.

Dependent claim 18 has been amended to specify that the second medium is comprised of television including video and audio and that the first medium is received in a digital data channel of a multichannel cable transmission that includes the second medium.

2. Independent Claim 20 And Claims Depending Therefrom

Claim 20 as amended sets forth outputting a multimedia presentation based on the step of controlling a receiver station to enable a coordinated presentation, through execution of processor instructions, of a first medium and information based on a second medium. Claim 20 is further amended to set forth that the information based on the second medium is generated based on identifying content of the second medium.

Dependent claim 21 is amended to delete unnecessary recitations and further specify that the first medium is comprised of a television program including video and audio.

Dependent claim 22 is amended to delete unnecessary recitations and to include the additional step of receiving the second medium in a digital data channel.

Dependent claim 23 is amended to delete unnecessary recitations and to further specify that the first medium comprises a television program including video and audio and that the plurality of signals is included in a multichannel cable transmission and includes a digital data channel including the second medium.

3. Independent Claim 24 And Claims Depending Therefrom

Claim 24 as amended sets forth outputting a multimedia presentation based on the steps of receiving a first medium, which includes a television program, and comparing first information stored at a receiver station to second information corresponding to content of the television program to determine whether to present a second medium based on third information received from a source different from that of the first medium. Amended claim 24 further specifies that based on the step of determining, a presentation of the television program with the second medium is coordinated and the television program of the multimedia presentation is output a first output device and the second medium is output at a second output device.

Dependent claim 25 is amended to delete unnecessary recitations and to further specify that the second output device comprises a printer.

4. Independent Claim 26 And Claims Depending Therefrom

Claim 26 as amended sets forth outputting a multimedia presentation by receiving at a receiver station a plurality of media from a remote transmitter station and another source, and processing the plurality of media in order to output the multimedia presentation. Amended claim 26 further sets forth the steps of identifying content of a first medium and content of a second medium based on the step of processing, and outputting the multimedia presentation comprised of a presentation of information included in the first medium and information based on a second medium, based on the identifying step.

Dependent claim 28 is amended to delete unnecessary recitations and to further include the step of storing information based on the second medium at the receiver station.

5. Independent Claim 29 And Claims Depending Therefrom

Claim 29 as amended sets forth outputting a multimedia presentation comprised of a first medium and a video image of a series of discrete video images by processing a control signal at a receiver station that causes execution of processor instructions to create a series of discrete video images. Amended claim 29 further sets forth the steps of identifying content of a first medium to be output in the multimedia presentation, causing one of the discrete video images to be output, and combining the outputted video image into the multimedia presentation based on the step of causing the video image to be output.

6. Independent Claim 33 And Claims Depending Therefrom

Claim 33 as amended sets forth outputting a multimedia presentation comprised of information included in a first signal and information included in a second signal by receiving a first signal from a remote transmitter station and outputting the first signal at a receiver station. Based on outputting the first signal, a user response is received and information corresponding to content of the first signal is compared at the receiver station to the user response. Based on the comparing step, the receiver station is tuned to receive a second signal and information included in the second signal is output as part of the multimedia presentation.

Dependent claim 35 is amended to delete unnecessary recitations and to further specify that the information included in the second signal is output to a printer.

7. Independent Claim 37 And Claims Depending Therefrom

Amended claim 37 defines a multimedia presentation apparatus comprising a receiver for receiving a plurality of signals, including at least two media, from a source external to the multimedia presentation apparatus. The multimedia presentation apparatus of claim 37 further comprises a microcomputer that stores information from a first medium and coordinates a presentation using the information with a presentation of a received second medium based on determining the content of the second medium. The multimedia presentation apparatus further comprises an output device that is operatively connected to the receiver and microcomputer for outputting the multimedia presentation to a user based on coordinating such that the presentation of information has a predetermined relationship to the content of the second medium.

Dependent claims 38-42 have been amended to conform to the amendments made to claim 37 from which they depend.

None of the proposed amendments add new matter, and all of the proposed amendments are supported by both the instant (*i.e.*, 1987) specification and applicants' 1981 specification in accordance with 35 U.S.C. § 112, first paragraph. *See, e.g.*, Declaration of Dr. Ligler attached as Exhibit 2.

B. Response To The General Denial Of Applicants' Priority Claim

1. Introduction

Despite applicants' detailed discussion in their May 6, 2002 Response to Interview Summary ("Response to Interview Summary") of the legal test for complying with 35 U.S.C. § 120 and the proper application of that test to the instant application, the Examiner and applicants continue to disagree regarding those issues. Some areas of disagreement stem from different views on what the law requires or what standard the law imposes, while other disagreements appear to stem from misunderstandings regarding the respective positions on the issues. In the following sections applicants respond to the issues raised by the Examiner generally in the order they appear in Section I of the Office action.

2. Restatement Of Applicants' Position On The Legal Requirements Of § 120

The test to determine whether a claim is entitled to the benefit of an earlier filing date under 35 U.S.C. § 120 is straightforward. The proper legal standard for satisfying § 120, as articulated on many occasions by the Federal Circuit, is that the claimed invention must be described in the parent application¹ in a manner that satisfies the terms of § 112:

A claim in a CIP [continuation-in-part] application is entitled to the filing date of the parent application when the

¹ While the case law addressing priority focuses on demonstrating written description support in the parent application, applicants acknowledge that the claims must also be supported under § 112 by the instant specification.

claimed invention is described in the parent specification in a manner that satisfies, *inter alia*, the description requirement of 35 U.S.C. § 112.

Therma-Tru Corp. v. Peachtree Doors Inc., 44 F.3d 988, 992, 33 USPQ2d 1274, 1276 (Fed. Cir. 1995). The crucial issue for determining if a claim is entitled to the filing date of an earlier application is whether the earlier application shows that the inventor was in possession of the claimed invention as of the date sought under § 120.

To qualify for an earlier filing date, section 120 requires, *inter alia*, that the earlier-filed U.S. patent application contain a disclosure which complies with 35 U.S.C. § 112, ¶1 (1994) for each claim in the newly filed application. Thus, this benefit only applies to claims that recite subject matter *adequately* described in an earlier application, and does not extend to claims with subject matter outside the description in the earlier application. In other words, a claim complies with 35 U.S.C. § 120 and acquires an earlier filing date *if, and only if, it could have been added to an earlier application without introducing new matter.*

Studiengesellschaft Kohle, m.b.H. v. Shell Oil Co., 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997) (citations omitted; emphasis added); *see also Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) (the earlier application “must describe [the claimed] invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought”); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115-16 (Fed. Cir. 1991) (““satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the *prima facie* date of invention can fairly be held to be the filing date of the application.””) (citation omitted).

Numerous cases further hold that compliance with § 120 allows for a parent and later filed CIP application to describe and support the claimed invention in *different* ways. Differences between what is disclosed and claimed in the two applications are

simply not relevant to satisfying § 120, as long as what is being *claimed* in the CIP application is supported under § 112 by the parent application and the later application.

There is ample support for applicants' position:

In order to determine whether a prior application meets the "written description" requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed.

See Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995);

[T]he earlier and later applications need not use identical words, if the earlier application shows the subject matter that is claimed in the later application, with adequate direction as to how to obtain it. . . .

. . . .

. . . [A]n invention may be described in many different ways and still be the same invention. In *In re Kirchner*, 305 F.2d 897, 904, 134 USPQ 324, 330 (C.C.P.A. 1962), the court held that compliance with section 120 "does not require that the invention be described in the same way, or comply with section 112 in the same way, in both applications."

Kennecott Corp. v. Kyocera Int'l, Inc., 835 F.2d 1419, 1422, 5 USPQ2d 1194, 1197 (Fed. Cir. 1987);

[I]t is evident that the salutary provision in the statute which confers the benefit of an earlier filing date is not dependant on that which may be gleaned from the claims or specification to be the subject matter regarded by the applicants as their invention in the earlier application. It turns on whether the *disclosure* requirements of the first paragraph of § 112 are met with respect to the subject matter *now* claimed.

Martin v. Johnson, 454 F.2d 746, 750, 172 USPQ2d 391, 394 (C.C.P.A. 1972);

[In *In re Brower*, 433 F.2d 813 (C.C.P.A. 1970)] we pointed out that 35 U.S.C. § 120 specifies only that the

previously filed application must disclose the invention “in the manner provided by the first paragraph of section 112,” and made it clear that there is no requirement under section 120 that the invention claimed in the subsequent application must correspond to what was regarded as the invention in the earlier application.

In re Ahlbrecht, 435 F.2d 908, 909, 168 USPQ 293, 294-95 (C.C.P.A. 1971).

In *In re Kirchner*, 305 F.2d 897, 134 USPQ 324 (C.C.P.A. 1962), the Court addressed a factual scenario similar to the instant application. In an opinion by Judge Rich, the Court concluded that the applicant was entitled to the priority date of the parent application even though the two disclosures were different. At the end of its decision the Court described the requirements of § 120:

Assuming the common inventorship, copendency, and cross-reference required by section 120, that section further requires only that the invention be disclosed in the parent application in such manner as to comply with the first paragraph of section 112 and be the same invention as that disclosed in the later application. It does not require that the invention be described in the same way, or comply with section 112 in the same way, in both applications.

Kirchner, 305 F.2d at 904, 134 USPQ at 330. While the *Kirchner* case focused on the different utilities being disclosed in the two applications for the same claimed invention, the *Kennecott* decision makes it clear that the claimed invention itself can be described differently in the earlier and later filed applications and still obtain the benefit of the earlier filing date. See *Kennecott*, 835 F.2d at 1422, 5 USPQ2d at 1197.

The case of *Martin v. Johnson*, 454 F.2d 746, 172 USPQ 391, addressed a situation in which an applicant had disclosed an invention in different ways in the parent and later filed applications. In that case, Johnson sought the benefit of the priority date of his parent application in an interference proceeding. The Court held that Johnson was entitled to the priority date of the parent application despite Martin’s contention that the invention disclosed in Johnson’s parent application was different from the invention disclosed and claimed in his CIP application. *Id.* at 748, 172 USPQ at 393. In response

to Martin's assertion that "the only thing carried forward through the line of cases asserted by Johnson is the mere name of the compound of the count," the Court concluded:

From the standpoint of the description requirement, the omission of the structural formula from the Johnson application is of no consequence.

The fact remains that the compound described is the same, and the description need not be in *ipsis verbis* to be sufficient. The fact that the effective amount of the compound may be different in the several [Johnson] applications is irrelevant. The [claim at issue in the interference] count is not directed to the method of using the herbicide where the effective amount might be a factor; it is drawn instead to the compound itself, and effective quantity is not an element.

Johnson, 454 F.2d at 751, 172 USPQ at 395 (internal citations omitted). As the *Johnson* decision makes clear, in performing the §§ 112 and 120 analysis, the focus must be on precisely what is being *claimed* in the CIP application. Differences between the disclosures in the parent and CIP applications are not relevant to the priority analysis as long as what is being relied on by the applicant provides sufficient support for the claim. Johnson's applications, for example, disclosed different mixtures of herbicidal compounds in which the effective amounts of the total herbicide and the effective amounts of the claimed compound varied with respect to the parent and CIP applications. Because the claim at issue in the interference count was directed to only the compound and because the claimed compound was disclosed in each of the different mixtures disclosed in the parent and CIP applications, the claim was entitled to priority under § 120.

Similar reasoning was applied in an analogous case addressing the issue of whether a claimed invention was reduced to practice. In *In re Dardick*, 496 F.2d 1234, 181 USPQ 834 (C.C.P.A. 1974) the issue was whether the applicant could swear behind a reference by showing that the claimed invention was reduced to practice prior to the date

of the reference. To demonstrate reduction to practice, the applicant submitted evidence under Rule 131 that a particular embodiment of the claimed invention was reduced to practice and tested. The Examiner, however, objected to the evidence of reduction to practice on the grounds that the reduction of practice was ““of an embodiment of an invention not disclosed in the application.”” *Id.* at 1239-40, 181 USPQ at 838. However, the Court held that there is “no legal requirement that the embodiment of an invention relied upon as a reduction of practice must be identical to that described in the application.” *Id.* In other words, undisclosed embodiments could be used to demonstrate reduction to practice as long as they show reduction to practice of what was being claimed—differences that did not relate to what was being claimed are irrelevant.

Because the case law clearly allows for an applicant to describe an invention differently in earlier and later filed applications and still obtain the benefit of the earlier filing date, it is not surprising that applicants have found no cases addressing compliance with § 120 which suggest that the two disclosures identified to support a claim should or need be compared for similarity. Instead, as discussed, the case law establishes that such a comparison is unnecessary and indeed improper. *See, e.g., Johnson*, 454 F.2d at 750, 172 USPQ2d at 394.

The test for satisfying § 112 in the priority context as set forth above does not deviate from the written description test under § 112 applied when § 120 is not invoked. In *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774, 64 USPQ2d 1945 (Fed. Cir. 2002), a case that did not involve § 120, the Court cited the proposition from *Eiselstein* that an application need not use the same terms as found in the claims to comply with § 112. The issue in *All Dental* was whether or not the claim term “original undefined mass” was supported under § 112 in the specification. The Court concluded that the term was supported by the specification even though the specification did not use that term. “[T]he failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon

reading the specification that the new language reflects what the specification shows had been invented.” *All Dental*, 309 F.3d at 779, 64 USPQ2d at 1948; *see also In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (“The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.”); *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996) (“the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question”). As applicants have consistently argued to the Examiner, upon reading the 1981 and 1987 specifications, one skilled in the art would recognize that the inventions claimed in the instant application reflect what was shown to have been invented in 1981. This is now confirmed by the accompanying Declaration of Dr. Ligler.

Section 120 imposes no requirement that a parent and a later filed application use identical or even similar disclosures to describe the claimed invention. The case law is clear that the relevant requirement under § 120 is that the subject matter actually being claimed in the later-filed application comply with the requirements of § 112, first paragraph. Accordingly, the starting point for any analysis under § 120 is what is currently being claimed, and the Examiner’s repetitious arguments focusing on comparing applicants’ two disclosures at an abstract level, without reference to specific claims or claim limitations, is unnecessary and improper.

3. Response To The Various Unsupported “Theories” Relied On By The Examiner For Denying Priority Under § 120

The Examiner has steadfastly refused to accept applicants’ 1981 priority claim with respect to all pending claims in this application. But in denying the 1981 priority

claim, the Examiner has failed to conduct the proper claim-by-claim analysis required under the controlling authorities set forth above. Instead, the Examiner has denied the priority claim based on a general comparison of the specifications to one another. This is plainly improper. *See Eiselstein*, 52 F.3d at 1038, 34 USPQ2d at 1470; *Kennecott Corp.*, 835 F.2d at 1422, 5 USPQ2d at 1197; *In re Ahlbrecht*, 435 F.2d at 909, 168 USPQ at 294-95. At times, the generalized denial of applicants' priority claim appears to be based on the notion that, because different words and phrases may be used to describe the claimed subject matter in the 1981 and 1987 specifications, the claims cannot be supported by both specifications. This basis, of course, flies in the face of several controlling Federal Circuit cases that clearly hold that *ipsis verbis* support is not required. *See Eiselstein*, 52 F.3d at 1038, 34 USPQ2d at 1470; *Kennecott Corp.*, 835 F.2d at 1422, 5 USPQ2d at 1197. At other times, the generalized denial appears to be based on the idea that the new subject matter included in the 1987 specification somehow causes the claimed "basic" subject matter to be nonexistent in the 1987 specification or somehow changed in character such that it cannot be relied upon to support claims. The accompanying Declaration of Dr. Ligler demonstrates that this is not the case.

Not surprisingly, the Examiner has provided *no legal authority* to support his outright denial of applicants' priority claim based on a general comparison of the 1981 and 1987 disclosures. Applicants believe that no such authority can be found. So instead, the Examiner has offered new "theories" to support the complete denial of applicants' priority claim. These "theories" include the "wobble room" theory, the "pledge" theory, the "smudge" theory, and the "metes and bounds" theory. Again, no *legal authority* is offered in support of these "theories." For this reason alone, applicants submit that all discussion of these "theories," and any rejections or objections based thereon, should be withdrawn. If the Examiner chooses to include these "theories" in the next Office action, applicants respectfully request that the Examiner provide citations to controlling legal authority that justifies these "theories." Notwithstanding the foregoing,

applicants respond below to the “merits” (to the extent any can be discerned) of the “theories.”

a. The “Wiggle Room” Theory

In Section I (C) of the Office action the Examiner introduces the “wiggle room” theory. In attempting to explain this theory, the Examiner presents a hypothetical in which a potential infringer is faced with the task of interpreting applicants’ pending claims, first, if such claims were to issue from the 1981 specification, and second, if such claims were to issue from the 1987 specification. Applicants are aware of no authority supporting the Examiner’s analysis which speculates on how a potential infringer would interpret claims pending during prosecution. The perspective of a potential infringer and how the Examiner thinks a hypothetical potential infringer would interpret, understand, or feel about claims pending during prosecution is irrelevant, unsupported by the law, and not a proper basis for a denial of priority under § 120. Claims that are properly supported by both specifications are entitled to the 1981 priority date. It is simply not relevant to the § 112 and § 120 analysis whether or not a potential infringer using, as the Examiner describes “an enhanced system,” would infringe the pending claims.

Applicants note that the Examiner’s apparent argument in his application of the “wiggle room” theory—that applicants claim of priority should be rejected because of alleged problems or issues that a potential infringer would encounter if applicants’ claims were granted the earlier priority date—is not a proper basis to deny applicants’ claims the priority date under § 120. There is no legal basis whatsoever that support such an argument. Further, applicants note that potential infringers could face the very situation described by the Examiner with respect to claims that issue from *any* CIP application containing new matter, regardless of the manner by which the parent application’s subject matter is disclosed in the CIP application. For example, if a basic invention is disclosed in a parent application, and a CIP application incorporates the parent application by

reference and also discloses a new embodiment of the basic invention as new matter, a potential infringer analyzing claims issuing from the CIP application faces the very same issues of claim interpretation as described by the Examiner. Specifically, any ambiguity as to whether CIP claims directed to the basic invention cover the new embodiment becomes less ambiguous by virtue of the disclosure of the new embodiment in the CIP application. This is true *regardless* of the manner by which the parent application's subject matter appears in the CIP (i.e., through incorporation by reference, in full text format, or otherwise). This flaw in the Examiner's "wobble room" theory is in part the result of the erroneous assumption that an applicants' specification or specifications are determinative of the scope of a given claim.² In short, the Examiner's "wobble room" theory concerning how a potential infringer might view applicants' claims is incorrect, improper, and irrelevant.

b. The "Pledge" Theory

In Section I (H) the Examiner asserts that "by claiming the benefit of section 120 priority for a given claim filed in a subsequently filed CIP application, an applicant is essentially '*pledging*' (e.g. putting everyone on notice) that the claim is directed 'solely' to the subject matter that is found within the specification of the Parent application, and not to any of the 'new subject matter' that has been introduced via the subsequently filed CIP." Office action, p. 13. Contrary to the Examiner's position, an applicant's decision to assert an earlier priority date under § 120 *does not* necessarily limit the scope of the claim in this manner. Instead, an applicant's decision to assert priority under § 120 simply demands that a particular claim be supported in both the earlier and later specifications. The scope of the claim is determined under the legal principles applicable

² This issue is raised several times in the Office action. Applicants further address the Examiner's erroneous contention that the scope of applicants claims is "necessarily" limited by the disclosure relied upon to support a particular claim below in their response to the Examiner's "pledge" and "metes and bounds" theories.

to claim interpretation. For example, if a parent application discloses a genus and the CIP discloses the genus and several new species, a claim issuing on the CIP application which claims the genus may be broad enough to cover the new species and be entitled to the benefit of the parent application's filing date, even though the species are first disclosed in the CIP. Of course, the content of both specifications may be relevant to the claim interpretation analysis; but there is no *per se* rule regarding the limits or bounds of a particular claim based on an applicant's claim to priority under § 120. There is simply no legal basis for the Examiner's position that by asserting priority to the 1981 specification, applicants have "pledged" that the *scope* of their claims is limited to what was disclosed in the 1981 specification and not to what is disclosed in the later application.

c. The "Smudge" Theory

In Section I (H) of the Office action, the Examiner asks "why should a pending claim having limitations that are directed to even a smudge of new 1987 subject matter be entitled to the earlier 1981 filing date of the Parent specification which did not disclose that smudge of new subject matter?" Office action, p. 14. Applicants are not entirely clear what point the Examiner is trying to make with this "smudge" theory. To the extent the smudge theory stands for the proposition that applicants' priority claim may be denied due to applicants' use of certain words or phrases in the 1987 specification that do not appear verbatim in the 1981 specification, the Examiner's "smudge" theory directly contradicts established legal authority which plainly holds that "earlier and later applications need not use the identical words" to describe the invention because "an invention may be described in different ways and still be the same invention." *Kennecott Corp.*, 835 F.2d at 1422, 5 USPQ2d at 1197. Accordingly, applicants are justified in citing to passages from the 1987 specification that may also include discussions of enhancements and improvements that are not described in the 1981 specification.

Applicants cite such passages from the 1987 specification because those passages also disclose the subject matter disclosed in the 1981 specification that is currently being claimed. This is further evidenced by the Declaration of Dr. Ligler.

As best applicants can ascertain, the Examiner relies on the “smudge” theory to penalize applicants for disclosing the subject matter from the 1981 specification in the 1987 specification in an integrated fashion with the new enhancements and improvements. The “smudge” theory ignores the fact that the subject matter disclosed in the 1981 specification also appears in passages relied upon by applicants from the 1987 specification—even if the same words and phrases are not always used to describe the same subject matter. The Examiner’s application of the smudge theory is tantamount to requiring applicants to point to *identical* support for a given claim, which is directly contradicted by the relevant legal authorities.

d. The “Specification Defines The Metes And Bounds” Theory

On pages 34-35 of the Office action the Examiner states his understanding that the “currently pending claims must be ‘directed’ to ‘subject matter’ that was described in applicant’s 1987 CIP specification whereby the ‘subject matter’ that is described in the specification effectively defines the metes and bounds of the claims’ limitations that are directed to it (e.g. the broadest reasonable interpretation that can be given to a claim.)” Office action, p. 34-35. Applicants do not fully understand this sentence.³ However, it appears that the Examiner asserts that the subject matter relied upon by an applicant to support a given claim defines the metes and bounds, or scope, of a given claim. As more fully set forth in their Response to Interview Summary, the Examiner’s “metes and bounds” theory is unsupportable and contrary to established legal authority. In contrast

³ As with the other “theories” addressed in this Section, applicants have not found any legal authority that sheds any light on the “metes and bounds” theory, nor has the Examiner cited any authority.

to the Examiner's use of the phrase "metes and bounds," many patent cases hold that a patent's *claims* define the metes and bounds, or scope, of the patent grant. Often, cases use the "metes and bounds" expression to stress that it is the patent claims, rather than what is disclosed in the specification, that defines the scope of the invention. *See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966-67 (Fed. Cir. 1989) ("A claim in a patent provides the metes and bounds of the right which the patent confers on the patentee to exclude others from making, using, or selling the protected invention.").

Interestingly, the parenthetical from the Examiner's quote identified above ("the broadest reasonable interpretation that can be given to a claim") appears to contradict the very proposition suggested by the Examiner's metes and bounds theory. As applicants have previously stated, the M.P.E.P. instructs Examiners that "pending claims must be 'given their broadest reasonable interpretation consistent with the specification.'" M.P.E.P. § 2111 (8th ed. 2001); *see also In re Bass*, -F.3d-, No. 02-1046, 2002 WL 31818303 (Fed. Cir. Dec. 17, 2002). The Examiner appears to interpret this M.P.E.P. instruction as saying that claims must be given their broadest reasonable interpretation *limited* to what is directed in the specification. But, of course, the M.P.E.P. does not say this, and neither do the controlling Federal Circuit cases. Thus, the M.P.E.P. and the Examiner's own parenthetical contradict the Examiner's position that a claim is defined by, and therefore limited to, what is disclosed in the specification.

Contrary to the Examiner's position, claims should not be limited to the embodiments disclosed in the specification. *See, e.g., Burke, Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 1340, 51 USPQ2d 1295, 1299 (Fed. Cir. 1999) ("Consistent with the principle that the patented invention is defined by the claims, we have often held that limitations cannot be read into the claims from the specification or the prosecution history."); *Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989) ("[T]his court has consistently adhered to the proposition

that courts cannot alter what the patentee has chosen to claim as his invention, that limitations appearing in the specification will not be read into claims, and that interpreting what is *meant* by a word *in* a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’”) (citation omitted).

The Examiner’s “metes and bounds” theory is contrary to established principles governing the interpretation of patent claims. The Examiner’s duty is to give the claims their broadest reasonable interpretation consistent with the specification. Limiting the claims to embodiments disclosed in the specification is improper when examining claims (or in any other context). When properly interpreted, it is clear that applicants’ claims are supported by both specifications as demonstrated, e.g., by the Declaration of Dr. Ligler.

e. Conclusion Regarding The Examiner’s “Theories”

In summary, the Examiner’s novel “theories” are improper, unsupportable and contrary to established legal precedent. The absence of any citations by the Examiner in support of these “theories” is particularly telling. The few cases the Examiner does cite to in the Office action actually support applicants’ view of the proper legal test under §§ 112 and 120. For example, in Section I (M) of the Office action, the Examiner cites the following additional passage from the *Kirchner* decision (a case upon which applicants rely to demonstrate the proper test under §§ 112 and 120):

And to determine what is the invention under consideration, one must be governed by the claims of the later application, because it is there one must look to determine what invention the “application for patent” referred to in the opening words of section 120 is for

Office action, p. 20 (quoting *Kirchner*). The quote identified by the Examiner simply reinforces applicants’ position that in performing an analysis regarding whether or not the requirements of § 120 is satisfied, the starting point is the invention (i.e., the pending

claims) in the CIP application. Similarly, the following quotation from the *Transco* decision relied on by the Examiner also stresses that the relevant inquiry is what is recited in the pending claims:

However, if a claim in a continuation-in-part application *recites* a feature which was not disclosed or adequately supported by a proper disclosure under section 112 in the parent application, but was introduced first or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application.

Office action, p. 31 (emphasis added) (quoting *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 558, 32 USPQ2d 1077, 1082 (Fed. Cir. 1994)).

Applicants fully agree with this quotation. The important point is that applicants' claims do *not recite* features which were first or only disclosed and described in the 1987 specification. The claimed features of the instant application are in fact described in both specifications.

Accordingly, applicants respectfully request that all discussion of the "theories," and any objections or rejections based thereon, be promptly withdrawn. Applicants further respectfully request a proper claim-by-claim analysis of the §§ 112 and 120 issues in view of the evidence presented by applicants—particularly the Declaration of Dr. Ligler. Applicants submit that this evidence plainly shows that both specifications describe the subject matter claimed in this application in the manner required by § 112, first paragraph, and that therefore, applicants' priority claim under § 120 is proper.

**4. Response To Specific Issues Raised In Section I
Of The Office Action**

**a. The Extent To Which Subject Matter
From The 1981 Specification Appears In
The 1987 Specification**

In Section I (A) of the Office action, the Examiner again questions the extent to which the subject matter of applicants' 1981 specification was "carried forward" into

applicants' 1987 specification. The Examiner argues that it is "impossible" to determine if any portion of the 1981 specification was "carried forward" into applicants' 1987 specification. The Examiner then asserts that "for this reason alone" applicants are not entitled to a 1981 priority date for any of the pending claims. As is often the case, the Examiner's position is not supported by any controlling legal authority. In the analysis of whether or not applicants are entitled to their 1981 priority date, the law does not require the Examiner to *first* determine what subject matter was carried forward from the 1981 specification into the 1987 specification. To determine if applicants are entitled to their 1981 priority date *with respect to a particular claim*, the Examiner must simply determine if *a particular claim* is supported under § 112, first paragraph, by each specification. Finally, regarding the Examiner's discussion of the "incorporation by reference" issue in Section I (F), applicants continue to maintain that it is unnecessary to incorporate by reference. No authority to the contrary has ever been provided by the Examiner. It is therefore improper for the Examiner to attempt to penalize applicants for incorporating their 1981 subject matter into the 1987 specification in an integrated fashion.

Further, contrary to the Examiner's assertions, applicants have, on numerous occasions in this application and in related pending applications, demonstrated that the features disclosed in the 1981 specification are also disclosed in the 1987 specification. In response, the Examiner asserts generally that:

only the "enhanced and improved" 1987 versions of the 1981 inventions actually exist within the instant 1987 CIP specification . . . (Office action, p. 6);

the "unmodified and unenhanced" 1981 subject matter described in the past 1981 Parent disclosure simply does not exist within the instant 1987 CIP disclosure . . . (Office action, p. 8, n. 4);

the "1981 inventions" from the 1981 specification were left behind at the time of the of filing the instant 1987 CIP

specification in favor of the enhanced/improved/modified
“1987 inventions” . . . (Office action, p. 10, n. 5);

the 1987 subject matter of applicant’s instant 1987 CIP
specification is “inconsistent” with the 1981 subject matter
of applicant’s past parent specification because the 1987
CIP specification has introduced 1987 “enhancements and
improvements” which effect [sic] the scope and meaning of
everything that is disclosed in the 1987 CIP specification.
(Office action, p. 35.)

These conclusory statements on this issue are supported with few examples. The few
examples that the Examiner does provide (concerning what the Examiner alleges in
Section I(V) of the Office action to be “inconsistencies” between the two specifications,
which are addressed below by applicants) cannot and do not support the sweeping and
unqualified statements cited above. The biggest problem, however, is that the Examiner
steadfastly refuses to conduct the proper claim-by-claim analysis when addressing the
§§ 112 and 120 issues. Instead, the Examiner relies on generalizations and a few
examples that are (a) incorrect and (b) *not tied to any particular claim*. This is improper.

Finally, the Examiner misrepresents applicants’ clear statement on this issue when
he asserts that “applicant now acknowledges that the 1981 application was not
incorporated into the 1987 application.” Office action, p. 54. What applicants actually
stated in their last Response was that the 1981 application “was not incorporated *by*
reference” into the 1987 application. Applicants have at all times maintained that the
subject matter from the 1981 specification is disclosed in the 1987 specification.

**b. The Mischaracterization And Misquoting
Of The ITC Decision**

In the discussion of the relationship between applicants’ two specifications, the
Office action quotes several passages from a decision issued in prior litigation pending
before the International Trade Commission (“ITC”) involving one of applicants’ issued
patents. In the discussion of the ITC decision, the Office action misquotes the published
decision and neglects to present the various passages in their proper procedural and

factual contexts. Due to numerous inaccuracies surrounding the ITC quotations, the entire discussion of this issue in the Office action is confusing and misleading. Placed in an accurate and proper context, the record from the ITC litigation actually supports applicants' position on the written description and priority issues.

Before addressing the specific passages quoted in the Office action, applicants must first provide a procedural overview of the ITC litigation. In the litigation before the ITC, the owner of applicants' issued patents and the assignee of the instant application, Personalized Media Communications L.L.C. (PMC), alleged that certain products imported into the United States infringed several claims of U.S. Patent No. 5,225,277. Following an evidentiary hearing, the ITC administrative law judge, Judge Luckern, issued a decision entitled "Initial and Recommended Determinations" (Initial Determinations) on October 20, 1997. *See In re Certain Digital Satellite Sys. (DSS) Receivers & Components Thereof*, No. 337-TA-392, 1997 WL 696255 (Int'l Trade Comm'n Oct. 20, 1997). In connection with the evidentiary hearing, three separate groups submitted briefs and arguments to Judge Luckern: 1) PMC; 2) the accused infringers (Respondents); and 3) the ITC Staff. Judge Luckern's Initial Determinations made various findings and concluded that: 1) claims 3, 6, 7, 12, 15, 35, and 44 were invalid as indefinite; 2) claims 3, 6, 7, 12, 15, 35, and 44 were invalid as not enabled; 3) claim 7 was invalid as anticipated; and 4) no asserted claim was infringed. Significantly, the Respondents challenged only one claim, claim 44, for lack of written description support. Judge Luckern found that claim 44 was *not invalid* under § 112, first paragraph, for a failure to provide proper written description support. *Thus no claim asserted in the ITC litigation was held invalid by Judge Luckern under 35 U.S.C. § 112, first paragraph, for failure to provide adequate written description support.*

On December 4, 1997, the ITC issued its Final Determination which adopted some, but not all, of Judge Luckern's Initial Determinations. Specifically, the ITC's Final Determination adopted Judge Luckern's claim constructions and findings that the

asserted claims were indefinite and not infringed. On the other hand, the ITC did not adopt Judge Luckern's other findings concerning, for example, whether the claims were enabled or whether claim 7 was anticipated. On appeal before the Federal Circuit were only those findings by Judge Luckern that the ITC expressly adopted in its Final Determination. The Federal Circuit's opinion: 1) reversed Judge Luckern's and the ITC's determination that the asserted patents claims were invalid for indefiniteness; 2) vacated Judge Luckern's and the ITC's determination that asserted claim 7 was not infringed; and 3) affirmed Judge Luckern's and the ITC's determination that claims 6 and 44 were not infringed. *See Personalized Media Communications, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 48 USPQ2d 1880 (Fed. Cir. 1998). As a result of the Federal Circuit opinion, the case was remanded to the ITC. After the case was remanded to the ITC, PMC withdrew its complaint and the ITC vacated Judge Luckern's Initial Determination with respect to the findings of invalidity for anticipation and lack of enablement. *See In re Certain Digital Satellite Sys. (DSS) Receivers & Components Thereof*, No. 337-TA-392, 2001 WL 535427 (Int'l Trade Comm'n May 13, 1999). Accordingly, the quotes relied upon by the Examiner in the Office action, all of which are from Judge Luckern's discussion of invalidity for lack of enablement, were vacated by the ITC.

The Office action fails to provide any substantive and procedural context for the various citations to Judge Luckern's Initial Determinations. For example, it fails to indicate that during the course of the ITC litigation *not one of the asserted claims was found to be invalid for failure to satisfy the written description requirement of § 112, first paragraph*. Second, it fails to mention that the ITC refused to adopt Judge Luckern's findings of invalidity based on enablement and, therefore, those findings were not reviewed by the Federal Circuit. Third, it does not point out that the Federal Circuit reversed all of Judge Luckern's and the ITC's conclusions that the asserted claims were invalid for indefiniteness under § 112, second paragraph. Finally, it fails to indicate that

Judge Luckern's findings on the enablement issue—where all of the Examiner's quotes originally appeared—were vacated by the ITC and have no legal effect whatsoever.

Even more disturbing is the Office action's misleading statements with respect to certain quotations. The first quote introduced in the Office action on this point is the following:

To the extent -- and I'm unaware of any significant differences between the '490 patent [the 44 pages of applicant's past 1981 Parent specification] and the '277 patent [the 557 pages of applicant's instant 1987 CIP specification]. I haven't seen one, and I don't remember it. Certainly, I made an effort early on to determine whether or not the disclosures of the '490 patent made their way into the '277 and although they're spread around and sometimes stated a little bit differently, for all relevant purposes of this hearing, the '490 patent is expanded by the '277. It's certainly not inconsistent.

Office action, p. 2. This quote is mischaracterized in the Office action as "testimony" of applicants' counsel before the ITC. This quote appears to be cited for the purpose of supporting the Examiner's unfounded argument that "no conscious effort to carry the '1981 subject matter' forward into the instant 1987 CIP specification ever appears to have been made..." Office action, p. 2. Using the above quote, the Office action appears to insinuate that if the lawyer responsible for preparing the 1987 application had to go back and review it to determine if the 1981 disclosure was included, then the 1981 disclosure must not be included in the 1987 application. This is grossly misleading.

First, this passage cited by the Examiner is not "testimony" before the ITC—it is an attorney's argument made by PMC's litigation counsel during closing arguments. Further, the attorney making the statement, Robert Taylor, has never represented applicants in connection with the preparation or prosecution of any of their patent applications. Because the attorney representing PMC in the litigation was not directly involved in prosecuting any of PMC's applications, it is not surprising that he would have to review the two specifications to determine how the 1981 specification was

incorporated into the 1987 specification in connection with his representation of PMC as litigation counsel. The fact that PMC's litigation counsel undertook such an effort, and concluded that the '490 patent is simply expanded by the '277 patent, is consistent with applicants' position, namely, that the subject matter from the 1981 specification is indeed included in the 1987 specification.

Regarding the second quote from Judge Luckern's Initial Determination discussing the length of the 1987 specification (appearing on page 3 of the Office action), applicants submit that Judge Luckern's observation that the 1987 specification is longer and contains additional material compared to the 1981 specification is of no consequence. The third quote from the Initial Determination is misquoted in the Office action. The correct quote, in which Judge Luckern comments on applicants' specifications, is identified below with the portion added by the Examiner in bold and in brackets:

the disclosure in the 24 columns of the '490 patent [the 44 pages of the past 1981 parent specification], if indeed it is **[at]** all carried forward, is interspersed among some 328 columns of the '277 patent [the 557 pages of the instant 1987 CIP specification]

Office action, p. 3. The inaccurate version of this quote misleads the reader into thinking that the author questioned whether *any* of the parent specification was carried forward. The accurate version of the quote makes it clear that at most, Judge Luckern questioned whether *all of* the parent specification was carried forward. In any event, Judge Luckern did not find that any of PMC's claims were invalid for failure to satisfy the written description requirement of § 112, and the other findings on the enablement issue which Judge Luckern was discussing were vacated.

Later in the Office action, the Office action again quotes the Initial Determinations out of context. The passage quoted on page 42 of the Office action is not Judge Luckern's opinion, but rather, the argument is one that was advanced in the brief submitted by the ITC Staff. The Examiner's citation to this passage in Judge Luckern's

Initial Determinations fails to attribute the passage as being a quote from the ITC Staff's brief filed in the litigation. Further, the quote does not at all support the Examiner's position. The Examiner contends that applicants had clearly argued in the ITC litigation that "the 1987 'SPAM' transport scheme was not disclosed within applicant's 1981 parent application." Contrary to the Examiner's assertion, the ITC Staff's brief indicated that PMC had simply noted its brief that the acronym "SPAM" was first introduced in the 1987 specification.

When the various citations to the Initial Determinations are presented accurately and in their proper substantive and procedural context, the citations do not support the Examiner's position. Indeed, the ITC record is consistent with applicants' position on the written description issue. The statements made by PMC's counsel are also consistent with applicants' position on the priority issue, and the other quotations are nothing more than dicta concerning a finding by Judge Luckern that was later vacated. Even if these findings had not been vacated, the observations by Judge Luckern do not contradict applicants' position that the pending claims are entitled to the 1981 priority date under § 120.

c. Common Subject Matter vs. Different Subject Matter

Applicants' addressed the Examiner's arguments related to the "common subject matter" issue in detail in their Response to Interview Summary. The disagreement on the "common subject matter" issue appears to stem from the different tests applied by the Examiner and applicants to determine what constitutes common subject matter. As best understood by applicants, the Examiner asserts that common subject matter only exists when each specification's disclosure "perfectly circumscribes" the same subject matter. In contrast, applicants assert that common subject matter exists if the relied upon disclosures from each specification both support the claim for which priority is asserted. As applicants have previously stated, there is no legal authority supporting the

Examiner's denial of applicants' priority claim based on a comparison of the specifications without regard to a specific claim. In contrast to the Examiner's test for common subject matter which would reject applicants' claim of priority without ever referring to a particular claim, applicants' test only can be performed in the context of a particular pending claim.

Similarly, the Examiner's dispute with respect to applicants' position that the written description support relied upon to support a given claim need not be identical (*i.e.*, different words and phrases can be used to support a given claim and satisfy § 120) is unwarranted. The Examiner's position directly contradicts the Federal Circuit's holding that "section 120 'does not require that the invention be described in the same way, or comply with section 112 in the same way, in both applications.'" *Kennecott*, 835 F.2d at 1422, 5 USPQ2d at 1197 (citation omitted). In fact, applicants are aware of no legal authority supporting the Examiner's position that the support relied upon by an applicant under § 120 must be compared to determine if it "perfectly circumscribes" the same subject matter. Under § 120, the relied upon support must satisfy the written description requirement of § 112 for the claim at issue, and if written description support exists in both specifications, there is common subject matter. It simply does not matter if the words and phrases are different, or if the support provided from the 1987 disclosure includes references to the enhancements and improvements (so long as what is being claimed is supported).

In Section I (M) the Examiner challenges applicants' interpretation of the *In re Kirchner* decision. The facts of the *Kirchner* case are undisputed. In that case, the identical chemical compound was disclosed in the parent and CIP applications. In the CIP application, however, a new utility for that compound was disclosed and the utility disclosed in the parent application was not carried forward into the CIP application. The Court of Custom and Patent Appeals concluded that the claims in the CIP directed to the

compound were entitled to the effective filing date of the parent application under § 120.
In re Kirchner, 305 F.2d at 903-904, 134 USPQ at 330.

The Examiner asserts that the *Kirchner* decision identifies two requirements that must be met to obtain the benefit of an earlier filing date under § 120:

- 1) that “the invention” being claimed in the later filed CIP application must have been disclosed in the earlier filed Parent application in such manner so as to comply with the first paragraph of section 112;
AND
- 2) that said “invention”, as disclosed in the parent application in a manner that complies with the first paragraph of section 112, **be the “same invention” as that which is disclosed in the later application.**

Office action, p. 20-21 (emphasis in original). Applicants see no reason to restate the clear language of *Kirchner*. Regardless, there is nothing about this restatement that sanctions an abstract comparison of applicants’ specifications outside of the context of a specific claim. What the *Kirchner* decision requires is that the invention—as defined by the *claims* (not the disclosure) of the CIP application—be disclosed in both applications. *In re Kirchner*, 305 F.2d at 903-904, 134 USPQ at 330. Each relevant claim defines only one invention, and although the invention must be disclosed in both applications, each application clearly can describe and support that invention in different ways.

In the instant application, each of the relevant inventions, as defined by the currently pending claims, is supported by similar disclosure from both specifications. *See* Declaration of Dr. Ligler. Applicants acknowledge that the 1987 disclosure contains numerous improvements and enhancements to the 1981 disclosure. Notwithstanding this fact, as long as each of applicants’ inventions claimed in the instant application is described adequately in both specifications, the test under § 120 is met. Contrary to the Examiner’s assertions, applying the straightforward test described by applicants to the instant claims will ensure that applicants’ do not obtain the benefit of a 1981 filing date for claims that include limitations of the various improvements and enhancements found

in the 1987 specification. If applicants attempt to include limitations of the improvements and enhancements from the 1987 specification in a given claim, that claim could not receive priority under § 120 because the claim could not be supported under § 112 by the subject matter disclosed in the 1981 specification. This does not mean, however, that applicants cannot rely on passages from the 1987 specification that include those improvements and enhancements to support a claim that does not include limitations of those improvements and enhancements. The question is whether or not the provided 1987 support describes the more basic inventions being claimed, regardless of whatever else those passages may also describe.

Further, contrary to the Examiner's allegations, applicants do not assert that different subject matter can be used to give a pending claim "different interpretations." In the following quote, the Examiner mischaracterizes applicants' position on this issue:

According to applicant's way of thinking, the only thing that applicant needs to do in order to obtain the earlier 1981 filing date for his pending amended claims is to show that each of his pending amending claims can be given different 1987 and 1981 claim interpretations which allows each claim to be respectively supported, in parallel, by "different subject matter" from the two specification. [sic]

Office action, p. 4. Applicants do not assert that a given claim must or should be interpreted in different ways when determining whether or not the claim is supported by the two specifications. A given claim must be given one consistent interpretation—the broadest reasonable interpretation—when determining if the claim is supported by the each specification. The Examiner's various allegations that, due to certain additions included in applicants' 1987 specification, the pending claims must necessarily (at least sometimes) be given two different interpretations is wrong. Following the mandate that the claims are to be given the broadest reasonable interpretation consistent with the specification, each claim can be interpreted in a clear and consistent manner with reference to both specifications.

Similarly, with respect to the instant application, as long as additional details or enhancements present in the 1987 specification are not inconsistent with a broad claim interpretation that would be supported by both disclosures, it would be improper to use details or enhancements from the 1987 specification to interpret a claim narrowly. Accordingly, the Examiner is wrong to conclude in Section I (C) of the Office action that “the instant 1987 disclosure imposes very real modifications onto the meaning/scope of the currently pending amended claims in a way that was not supported by the past 1981 Parent specification as originally filed.” Office action, p. 8. *See* Declaration of Dr. Ligler, ¶¶ 43-57.

d. Applicants Claims Are Directed To The Same Inventions Disclosed In Both Specifications

To counter applicants’ position that the pending claims are entitled to a 1981 priority date, Examiner asserts that inventions described in the 1981 specification and the inventions described in the 1987 specification are “different inventions.” *See* Section (I) (B) of the Office action.

Applicants’ acknowledge that the 1987 specification contains significant new matter that is not found in the 1981 specification. Notwithstanding this fact, the relevant inventions are defined by the scope of each pending claim, and each pending claim is supported by a description of that particular invention in both specifications. An invention may be described in different ways and still be the same invention, and applicants continue to maintain that those features of the basic system disclosed in the 1981 specification which applicants rely on for § 112 support are also found in the 1987 specification. Often the same or very similar language is used to describe the systems/methods and the systems/methods’ elements/steps in the 1981 and 1987 specifications.

As applicants explained in their Response to Interview Summary, the fact that applicants' CIP application includes new matter is not evidence that applicants did not carry forward the previously disclosed subject matter into the 1987 specification. Many of the signals described in the 1987 specification under the discussion of SPAM perform the same functions as signals described in the 1981 specification. Just because the functionalities of such signals are disclosed in the context of a SPAM messaging protocol in the 1987 specification does not mean that signals performing the same functions were not disclosed in the 1981 specification. *See, e.g.*, Declaration of Dr. Ligler, ¶¶ 24, 39, 40, and 56. Accordingly, these control and instruct signals are described by both specifications, even though they may be disclosed in the context of a SPAM messaging protocol in the 1987 specification.

**e. Applicants' Reliance For § 112 Support
On Portions Of The 1987 Specification
That Include Details And Enhancements
Not Found In The 1981 Specification Is
Proper**

The Examiner takes issue with the support applicants have identified in the dual column charts provided for each of the pending claims. The written description support from the 1987 specification identified by applicants for many of the currently pending claims are examples from the 1987 specification that also include details and enhancements that are not found in the 1981 specification. The Examiner appears to argue that because the passages that applicants rely on from the 1987 specification include these details and enhancements, applicants are automatically precluded from obtaining priority for those claims under § 120. The Examiner's position is incorrect. Just because the 1987 specification discloses new details and enhancements to the general system, it does not mean that the basic aspects of the more advanced system cannot be used to support a claim directed to those basic aspects or features. The following passage from Section I (E) of the Office action highlights the Examiner's misunderstanding:

Apparently, it is applicant's position that the added/new 1987 subject matter contained within applicant's own citations of alleged section 112-1 support should be weeded out, discarded and/or ignored in order to allow the alleged underlying principles, ones that were allegedly carried forward from the past 1981 parent specification, to emerge therefrom (thereby allowing applicant's subsequently filed CIP claims to obtain the earlier 1981 filing date of the parent application). The examiner thinks not!

Office action, p. 11. First, applicants want to make clear that it is not their position that the details and enhancements disclosed in applicants' 1987 specification need to be "weeded out, discarded and/or ignored" to allow those basic aspects or features of the 1987 disclosure which are also disclosed in the 1981 specification to "emerge therefrom." For a claim to be entitled to an earlier priority date under § 120, a claim must simply be supported under § 112 by both specifications. In determining whether or not a claim is properly supported under § 112, an Examiner is not required to weed out, discard, or ignore certain portions of the specification—the specification either contains the necessary support or it does not.

As applicants have already stated, the starting point for analyzing the § 112 and § 120 issues is what is recited in the claims. In the 9/04/01 and 7/30/02 Office actions, the Examiner has repeatedly indicated his wholly unsupported belief that applicants' are reciting in the instant claims the improvements and enhancements that are found only in the 1987 specification. For example, in the 9/04/01 Office action the Examiner stated:

Clearly, the "more sophisticated" 1987 alleged inventions that are *necessarily being claimed* are not entitled to the 1981 filing date

[A]ll limitations of the currently pending claims are necessarily directed to that which is described in the present 1987 disclosure; namely, the more "sophisticated" systems/methods of the present 1987 disclosure.

9/04/01 Office action, pp. 19, 60. Applicants, in their 2/04/02 Response quoted the second quote identified above as follows:

all limitations of the currently pending claims are necessarily [only] directed to that which is described in the present 1987 disclosure

2/04/02 Response, p. 100. Applicants added the word “only” (clearly bracketed to reflect that it was not the Examiner’s original language) to point out applicants’ understanding of the Examiner position on this issue. Specifically, applicants understand the Examiner’s statements above to mean that he is of the view that the claims of the instant application must be claiming subject matter disclosed in the 1987 specification but that is *not disclosed* in the 1981 specification.

In the 7/30/02 Office action, the Examiner now quotes this passage from applicants’ 2/04/02 Response, but omits the bracketed “only” language. Thus, several times in the 7/30/02 Office action the following *inaccurate* statement appears, which is attributed as “applicants’ position:”

the [examiner’s] assumption that ‘all limitations of the currently pending claims are necessarily directed to that which is described in the present 1987 disclosure’ is mistaken and wholly unsupported.

Office action, p. 15, 54, 59. *This is not applicants’ position and applicants did not make the quoted statement.* In their 2/04/01 Response, applicants’ position was simply that the Examiner has incorrectly, and without support, asserted that applicants’ claims recite the “sophisticated,” or enhanced or improved subject matter that is disclosed *only* in the 1987 specification. Had the Office action simply quoted applicants correctly, applicants’ position would have been clear. However, by misquoting applicants’ prior Response, the Office action appears to characterize applicants’ position as being something that they have never asserted. Applicants’ position has been consistent: 1) the pending claims do not recite the improved subject matter that is only disclosed in the 1987 specification; and 2) the pending claims are supported by subject matter that is disclosed in both specifications.

In Sections (G) and (H) of the Office action, the Examiner again asserts that applicants are claiming improved subject matter disclosed in the 1987 specification. Applicants' maintain that none of the currently pending claims recite the "improved" subject matter which *would only* be supportable by the details and enhancements found in the 1987 specification. Instead, all of the pending claims can be, and are in fact, supported by the basic aspects or features that are found in to both specifications—even if applicants identify portions of the 1987 specification that also contain, in addition to the basic aspects or features disclosed in the 1981 specification, certain details and enhancement only found in the 1987 specification. If a claim includes limitations of the improvements or enhancements found in the 1987 specification (i.e., the broadest reasonable interpretation of that claim is such that the claim is limited to the improvements or enhancements), then that claim cannot be supported by the 1981 specification. But this is simply not the case with the claims of the instant application.

f. Applicants' "Dual" Column Support Charts

The Examiner's assertion in Section I (I) of the Office action that applicants "do[] not wish to cite, or indeed [are] unable to cite section 112-1 support from the instant CIP disclosure for these limitations" is unwarranted. Office action, p. 16. By the time the Examiner issued the 7/30/02 Office action, applicants had provided the Examiner with the detailed dual column support charts (that the Examiner finds "most helpful," Office action, p. 16) *in every single pending application in which applicants assert a 1981 priority date*. Accordingly, it is simply disingenuous for the Examiner to state "[a] noteable [sic] exception being the most helpful claim charts of alleged "dual" § 112 support which applicant has, only on a few occasions, been willing to kindly provide." Office action, p. 15, n. 9.

In a very confusing portion of the Office action beginning on page 53, the Examiner denies that he has ever "objected" to applicants' submission of the dual column

support charts, despite the appearance of the following passage in the 9/04/01 Office action:

At most, applicant might have to provide a cursory explanation as to how the limitations of the pending claim are supported by such identified "EXAMPLE"/"SECTION". So where is it? Instead of citing a section/example and quickly explaining how support is provided for each claim the cited example/section, applicant has shown that he feels the need to provide massive exhibits which map limitations of the pending amended claims to scattered portions of the present omnibus 1987 disclosure.

9/04/01 Office action, p. 50 (footnotes omitted). Applicants acknowledge that the Examiner has since made it clear that the support charts are appropriate and helpful.⁴ But certainly, applicants' concern regarding the Examiner's reaction to the support charts was justified in view of the above-quoted passage.

In the instant Response applicants also include a declaration by an expert, Dr. Ligler, that explains how applicants' claims are supported by both specifications. Accordingly, applicants have provided: 1) detailed charts demonstrating precisely where in each specification the relevant support exists for each claim limitation; 2) narrative summaries explaining how the relied upon support from each specification supports each claim in a similar fashion; and 3) an expert declaration further addressing the adequacy of the support relied upon by applicants for the claims, as amended. Applicants respectfully request that the Examiner respond, on a claim-by-claim basis, with a reasoned analysis as

⁴ It should be noted that in response to the objections in the 9/04/01 Office action regarding the charts that applicants had submitted in its copending applications, in the instant application applicants provided (in addition to the charts) narrative summaries which explain how each claim (as amended) is supported by both specifications, as suggested by the above-quoted passage. In spite of the considerable effort that was undertaken by applicants to provide these summaries of how each claim is supported by both specifications, the Examiner did not respond to or even acknowledge the summaries in the recent Office action.

to why the ample evidence of written description support provided by applicants for each claim does not meet the requirements of § 112, if those rejections are maintained.

In Section III the Examiner also asserts that applicants have “misled” the Examiner and the Office about the requirements of §§ 112 and 120. Specifically, the Examiner relies on the following quote from a paper filed by applicants:

The present application claims priority under 35 U.S.C.
§ 120 of the following applicationsConsequently,
Applicants will demonstrate disclosure only with respect to
the '81 case . . .

Office action, p. 53. First, applicants firmly deny ever having misled the Examiner or the Patent Office about what is required under §§ 112 and 120. The above quote, which originally appeared in applicants' 8/6/97 Amendment filed in application Ser. No. 08/470,571 (“the ‘571 application”), simply reflects applicants' long held view that the claims of the ‘571 application, as well as the claims of the instant application, are entitled to the 1981 priority date. The Examiner is incorrect in his implication that applicants misled the Office into believing that the 1987 specification was somehow irrelevant to complying with §§ 112 and 120. Indeed, in the very document cited by the Examiner, applicants provided citations in footnotes to the 1987 specification (which corresponded to the 1981 specification citations also provided in the same paper) when demonstrating written description support. *See* 8/6/97 Amendment filed in the ‘571 application, at p. 20.

Applicants note that the Examiner's unjustified, and in fact, improper allegation has nothing to do with his criticism of applicants' submission of the dual column support charts. Rather than support the Examiner's position that applicants have somehow “misled” the Office on the legal requirements for priority, the dual column support charts actually demonstrate applicants' extensive efforts to assist the Examiner in determining that the claims are supported by both specifications. Further, applicants have voluntarily identified to the Examiner precisely which of applicants' copending applications are entitled to a 1981 priority date and which are not. The law clearly does not require this

(until such time that an intervening reference is applied that applicants wish to antedate). And, of course, both specifications have been before the Examiner during the entire course of prosecution, thereby allowing the Examiner to conduct any appropriate analysis required with respect to the §§ 112 and 120 issues.⁵

Finally, applicants note that it is improper for the Examiner to make such allegations. These allegations unfairly disparage applicants and, in applicants' view, improperly discredit the Office. Indeed, the M.P.E.P. prohibits Examiners from commenting on such issues. *See* M.P.E.P. § 2010. In fact, the very Appendix cited by the Examiner in Section III (i.e., the Appendix to the document mailed on 9/10/01 in application Ser. No. 08/474,139) was withdrawn by the Patent Office pursuant to § 2010 of the M.P.E.P. because the allegations made therein "are unrelated to the issue of patentability of the subject matter claimed in applicants' pending applications and were not made pursuant to a duty of the Examiner imposed by law." *See* Interview Summary mailed on 3/21/02 in application Ser. No. 08/474,139. Accordingly, these improper allegations must be withdrawn, along with any rejections or objections based thereon.

**g. The Examiner's Struggle With
Determining What Exactly Is Being
Claimed In Applicants' Pending Claims**

In Section I (I) of the Office action the Examiner discusses his difficulty in determining what exactly is being claimed by applicants in their pending claims. Contrary to the Examiner's assertions, applicants have provided substantial assistance (e.g., the support charts, narrative summaries of support, detailed responses to the Examiner's § 112-1 "Examples" in the 9/04/01 Office action, and now Dr. Ligler's

⁵ Applicants note that they have relied on ample controlling authority to support their position on the requirements of §§ 112 and 120. In contrast, applicants have had to contend with the wholly unsupported "wiggle room," "pledge," "smudge," and "metes and bounds" theories advanced in the Office action.

Declaration) to the Examiner with respect to what exactly is being claimed in the pending application and how each claim is supported under § 112 in both specifications.

The Examiner's attempt to support his position that he has difficulty understanding what applicants are claiming in the instant application by relying on various quotations from Judge Luckern's Initial Determination in the ITC litigation (*see* Section I (I), p. 16-17) is without merit. First, as applicants have already noted, with respect to the only claim even challenged under the written description requirement of § 112, Judge Luckern concluded that the claim was not invalid on that basis.⁶ Second, Judge Luckern's belief that the 1987 specification is "difficult to understand as it is dealing with many possible systems," even if true, is not a proper reason for the Examiner to conclude that none of applicants' claims are supported under § 112. Further, the comments advanced by the Staff in the ITC litigation describing "directions to a treasure map" and "ships passing in the night" can hardly be applicable to the instant application. In the instant application, applicants have gone to great lengths to provide, explain and demonstrate exactly how the pending claims are supported in both specifications. Finally, as the attached Declaration of Dr. Ligler demonstrates, one of ordinary skill in the art would recognize that the subject matter of applicants' claims is adequately described by both specifications.

The Examiner apparently has difficulty with the fact that applicants at times are claiming inventions in the pending claims that do not use precisely the same words that are disclosed in the 1987 and 1981 specifications. The fact that the identical words are not used in applicants' claims is of no consequence as long as one skilled in the art would recognize that applicants disclosed that invention in both specifications. *See Eiselstein*, 52 F.3d at 1038, 34 USPQ2d at 1470; *Kennecott Corp.*, 835 F.2d at 1422, 5 USPQ2d at

⁶ Additionally, in allowing the claims asserted in the ITC to issue, the PTO understood that those claims were adequately supported under § 112.

1197. In determining “what exactly is being claimed” the Examiner appears to rely on the specification(s) to limit the scope of the claims. For example, with respect to many of applicants’ pending claims, the Examiner looks to the support relied on by applicants in their 1987 specification, and then, in interpreting the pending claim, the Examiner reads the various details from the relied upon support in the 1987 specification into the pending claims. After the Examiner has interpreted the claims to “necessarily” incorporate and be limited to the details found in applicants’ 1987 specification, the Examiner concludes that the claim cannot possibly be supported by the 1981 specification because the details that the Examiner has found to be incorporated into the claims are not present in the 1981 specification. The Examiner’s analysis is flawed. The proper analysis of whether written description support exists for a pending claim and whether a pending claim is to be entitled to an earlier priority date begins with the language of the claim. Of course, in interpreting a claim the Examiner can, and indeed should, use the relevant portions of the specification to understand and interpret the claim, but the Examiner must give the claim the broadest reasonable interpretation consistent with the specification. Then the Examiner must determine whether the claim is supported under § 112, first paragraph, by the instant 1987 specification, and then by the 1981 specification.⁷ As applicants have repeatedly and consistently asserted, the portions of the 1987 specification identified by applicants to support a particular claim include the basic subject matter disclosed in the 1981 specification. The fact that portions of the 1987 specification relied upon by applicants to support a particular claim may also include various details, enhancements and/or improvements that are not found in the 1981 specification is of no consequence.

⁷ The Examiner and applicants agree that because applicants’ position on priority has been challenged, the Examiner must first determine whether or not § 112 support exists in the 1987 specification. Only after the Examiner has concluded that support exists in the 1987 specification does the Examiner need to determine whether or not support exists in the 1981 specification.

In Section I (T) of the Office action, the Examiner contends that applicants are improperly using the “new and “expanded” 1987 disclosure:

- 1) to expand and/or modify the teachings which were originally conveyed by the disclosure of his 1981 parent application;
- 2) to draft new amended claims based on these “new”, “expanded”, and/or “modified” teachings of the 1987 CIP disclosure so as to impart the “new” and “expanded” 1987 scope and meaning to the newly drafted amended claims; and then
- 3) to allege that the amended claims, having the “new” and “expanded” 1987 scopes and meanings, are entitled to the 1981 priority of the originally filed parent disclosure which does not support these “new” and “expanded” 1987 scopes and meanings.

Office action, p. 34. The primary flaw in the Examiner’s argument is the notion that simply relying on support from the 1987 specification, automatically “imparts” a scope or meaning to the claims such that they are limited to the “new” or “enhanced” teachings from the 1987 specification. There is absolutely no legal basis to support the Examiner’s assumption that details from the specification must be read into the claims as limitations. If the “new” or “enhanced” teachings from the 1987 specification do not exist in the language of a currently pending claim the claim need not be, and in fact should not be, interpreted by the Examiner to include such “new” or “enhanced” teachings. *See In re Bass*, -F.3d-, No. 02-1046, 2002 WL 31818303 at *2 (Fed. Cir. Dec. 17, 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification.”); M.P.E.P. § 2111 (“pending claims must be ‘given their broadest reasonable interpretation consistent with the specification’”).

The Examiner makes a similar allegation in Section I (R) of the Office action where he asserts that

[The] 1987 teachings that only exist within the instant “1987” disclosure necessarily contribute to the scope/meaning that must now be given to the limitations of the currently pending amended claims and thus, there is simply no way that these claim limitations can be interpreted as being limited **solely** to subject matter which was adequately disclosed in the 1981 parent application via all of the requirements of section 112.

Office action, p. 32 (emphasis in original). As already explained above, the Examiner is simply incorrect from both a factual and legal perspective, in his assumption that certain enhancements and improvements that are found in the 1987 specification but not in the 1981 specification *must* be read into the scope or meaning of applicants’ currently pending claims. The crucial point that the Examiner does not appear to accept is that none of applicants’ pending claims contains limitations of the enhancements, improvements or details that are found only in the 1987 specification. While the passages from the 1987 specification that applicants rely on to support their pending claims may include various enhancements, improvements and details not found in the 1981 specification, they also include those basic or general aspects which *are* also disclosed in the 1981 specification. *Applicants’ position on this issue is made abundantly clear by the fact that all of the pending claims can, in fact, be supported by the subject matter disclosed in the 1981 specification which does not contain any of the improvements or enhancements. See Declaration of Dr. Ligler.*

h. Although Differences Between The 1981 And 1987 Specifications Exist, There Are No Significant Inconsistencies Between The Two Specifications

In Section I (J) of the Office action the Examiner lists several examples which allegedly support his position that there significant inconsistencies between the 1981 and 1987 specifications. First, without providing any detail or analysis the Examiner asserts that 1987 specification “sets forth circuit configurations for the current 1987 inventions which differ from the circuit configurations of the past ‘1981 inventions’ . . .” Office

action, p. 17. Even though there are some differences between the circuit configurations described in the two specifications, the configurations are not inconsistent and there is no reason why such differences would preclude applicants from demonstrating sufficient § 112 support in each specification for the pending claims. Indeed, as shown below, there are *substantial similarities* between the circuit configurations of both disclosures, which support applicants' position that the 1981 subject matter *has* been carried forward into the 1987 specification.

Again, as discussed above, the starting point for analyzing whether a claim is supported under § 112 and whether a claim should be entitled to an earlier priority date under § 120 is determining what is being claimed. Differences between the support that is relied upon by an applicant in two specifications are irrelevant as long as what is being relied on by the applicant in both applications provides sufficient support for the claim. *See Johnson*, 454 F.2d at 751, 172 USPQ at 395. Second, the Examiner also alleges that the 1987 specification sets forth more advanced signaling structures and processing than found in the 1981 specification. Again, even if true, the enhanced and improved signaling structure and processing of the 1987 specification do not preclude applicants from demonstrating sufficient § 112 support in each specification. Third, the Examiner alleges that certain "blocks" in the 1987 diagrams have "new/expanded/different" functions and operations associated with them compared to the 1981 specification. Office action, p. 17 The Examiner fails to identify any specific example from the diagrams and does not even argue the alleged differences are at all inconsistent. Fourth, and again without reference to any specific examples, the Examiner alleges in Section I (J) of the Office action that applicants use certain terminology differently and inconsistently in the two specifications. Without reference to specific examples, applicants cannot meaningfully respond to the Examiner's unsupported allegations.⁸

⁸ Applicants do respond in detail to *specific* examples addressing alleged inconsistencies raised by the Examiner in Section I (V) of the Office action.

Applicants note, however, that unless the alleged “inconsistencies” and alleged use of “different terminology” prevents applicants from demonstrating that a specific claim or claim limitation is adequately supported by both specifications, the Examiner’s allegations are not relevant.

In Section I (K) the Examiner asserts that he must compare applicants’ two specifications in order to determine whether the specifications “describe the same invention, contain common subject matter or have descriptions that are inconsistent, etc.” Contrary to the Examiner’s assertions, applicants’ position is not that the Examiner cannot perform such comparisons. Instead, applicants simply believe that none of these comparisons are required under the proper legal tests applicable to § 112 and § 120.

**i. The Examiner’s Continued Discussion Of
“Programming”**

Applicants and the Examiner continue to disagree over their interpretation of the term “programming” and the use of that term in applicants’ 1981 and 1987 specifications. In applicants’ view, which is set forth in detail in their Response to Interview Summary, the Examiner continues to interpret the 1981 definition in a unjustifiably narrow manner.

In the instant application, as amended, the term programming is not at all used in the claims. Although applicants’ continue to disagree with the Examiner regarding applicants’ ability to use the term “programming” in claims for which applicants claim 1981 priority, *see also* Declaration of Dr. Ligler, ¶¶ 44-47, the issue is moot in this application. Applicants, however, reserve their right to further address the “programming” issue, if and when the issue is pertinent to any pending claim.

**j. The Examiner’s Examples Of
“Inconsistencies” Between The 1981 And
1987 Specifications**

In Section I (V) the Examiner identifies and discusses several alleged inconsistencies between the two specifications. As an initial matter applicants submit

that any perceived inconsistencies are only relevant to the extent that the alleged inconsistency impacts or affects a pending claim. It is simply improper for the Examiner to continue to focus on alleged “differences” or “inconsistencies” without reference to a specific claim.

(1) Programming

Applicants have stated above that the Examiner’s discussion of the “programming” issue is not relevant to the instant application because they do not use that term in any pending claim. In Section I (V) of the Office action, the Examiner contends that even if applicants avoid literally using the term “programming” in the claims, “the ‘expanded’ 1987 definition of the ‘programming’ terminology nonetheless continues to impart its expanded scope and meaning onto all of the 1987 disclosures that are described in terms of this expanded 1987 ‘programming’ definition.” Office action, p. 37. Applicants do not understand what the Examiner means when he asserts that the 1987 definition of programming somehow “impart[s] its expanded scope and meaning onto all of the 1987 disclosures that are described in terms of this expanded 1987 ‘programming’ definition,” and the Examiner provides no examples to support this statement. Applicants do not see how the “programming” issue can be relevant to claims that do not use that term. *See also* Declaration of Dr. Ligler, ¶¶ 44-47. If the Examiner disagrees, the impact must be explained in the context of specific pending claims—not in a generalized manner that fails to take into account the subject matter being claimed.

The Examiner further asserts that “these expanded 1987 disclosures continue to impart expanded 1987 scopes and meanings onto the limitations of the currently pending amended claims which necessarily derive required section 112 support therefrom.” Office action, p. 37. As applicants have stated above, it is improper for the Examiner to use the written description support that applicants rely on from the specifications to read limitations from the specification(s) into applicants’ claims when the claims do not

expressly contain those limitations. Accordingly, the Examiner's position contradicts the prohibition of reading limitations from the specification into a claim, *see Burke*, 183 F.3d at 1340, 51 USPQ2d at 1299; *Intervet*, 887 F.2d at 1053; 12 USPQ2d at 1476, and the requirement that an Examiner give pending claims their broadest reasonable interpretation consistent with the specification. *See In re Bass*, -F.3d-, No. 02-1046, 2002 WL 31818303; M.P.E.P. § 2111 (8th ed. 2001). The Examiner's attempt to read the definition of programming from the 1987 specification into currently pending claims that do not use that term is improper and contrary to the law.

**(2) The Signaling Structures Disclosed
In The Specifications**

(a) Introduction

The inventions disclosed in both specifications and claimed in the instant application are generally directed to transmitting and processing of signals that are transmitted and then received at receiver stations. The 1981 and 1987 specifications both use various terminology to describe the numerous types of "signals" that are transmitted to, among other things, receiver stations. For example, the specifications disclose signal words, signal units, instruction signals or instructions, identifier signals or identifiers, control signals, commands and many other specific signals. Additionally, the specifications disclose several embodiments for embedding the various types of signals. For example, the 1981 specification discloses that signals:

may run and repeat continuously throughout the programing or they may run only occasionally or only once. They may appear in various and varying locations. In television they may appear on one line in the video portion of the transmission, or on a portion of one line, or on more than one line, and will probably lie outside the range of the television picture displayed on a normally tuned television set. In television and radio they may appear in a portion of the audio range that is not normally rendered in a form audible to the human ear. In television

audio, they are likely to lie between eight and fifteen kilohertz. Signals may also be transmitted on frequencies outside the ranges of television and radio. Different and differing numbers of signals may be sent in different and differing word lengths and locations.

1981 Specification, col. 4, ll. 15-30.

The 1987 specification similarly discloses these ways of embedding and transmitting signals:

In programming transmissions, given signals may run and repeat, for periods of time, continuously or at regular intervals. Or they may run only occasionally or only once. They may appear in various and varying locations. In television they may appear on one line in the video portion of the transmission such as line 20 of the vertical interval, or on a portion of one line, or on more than one line, and they will probably lie outside the range of the television picture displayed on a normally tuned television set. In television and radio they may appear in a portion of the audio range that is not normally rendered in a form audible to the human ear. In television audio, they are likely to lie between eight and fifteen kilohertz. In broadcast print and data communications transmissions, the signals may accompany conventional print or data programming in the conventional transmission stream but will include instructions that receiver station apparatus are preprogrammed to process that instruct receiver apparatus to separate the signals from the conventional programming and process them differently. In all cases, signals may convey information in discrete words, transmitted at separate times or in separate locations, that receiver apparatus must assemble in order to receive one complete instruction.

1987 Specification, P. 14, ll. 3-25. Thus, contrary to the Examiner's assertions, there is substantial overlap in the disclosures of various means and manners for embedding and transmitting signals.

Applicants acknowledge that certain details related to the enhanced and improved embodiments for embedding and transmitting signals disclosed in the 1987 specification are not expressly disclosed the 1981 specification. Applicants do not, however, include

these limitations in the pending claims of the instant application. Despite this fact, the Examiner continues to argue in the abstract and without reference to any particular claim, that none of applicants' claims are entitled to the 1981 priority date because applicants' two specifications disclose different and inconsistent signaling technology:

The examiner notes that "SPAM" technology, on which the "more sophisticated" systems of applicant's present 1987 disclosure are based, is vastly different from the "cuing-type signal" technology on which the "primitive" systems of applicant's 1981 parent application were based; e.g. the ability of SPAM to carry and distribute "software" being but just one of the more notable difference. Clearly, the "more sophisticated" 1987 alleged inventions that are now *necessarily being claimed* are not entitled to the 1981 filing date of their 1981 "primitive" ancestors; i.e. applicant is not allowed to transport his "more sophisticated" 1987 alleged inventions back in time to the 1981 filing date of his different, albeit sometimes "correlated", "primitive" 1981 alleged inventions.

Office action, p. 87 (emphasis in original). While the above quote mischaracterizes the enhanced and improved signaling technology disclosed in 1987 and the signaling technology disclosed in the 1981 specification, the most egregious flaw in the Examiner's argument above is in his assertion that applicants are "now necessarily" claiming the "more sophisticated systems" disclosed in the 1987 specification. Even a brief review of the claims actually pending in the instant application demonstrates that applicants have not included limitations of any such improvements or enhancements found only in the 1987 specification. The Examiner, however, steadfastly refuses to support his position with references to or analyses of specific claims.

The following sections address the Examiner's allegations of how applicants' disclosures related to signaling are inconsistent.

(b) Instruct Signals

The Examiner asserts that the "instruct signals" disclosed in the 1987 specification are inconsistent with the "instruct signals" disclosed in the 1981

specification. The Examiner's assertion is incorrect. The term "instruction signal" is used in the 1987 specification in the discussion of the Wall Street Week ("WSW") example. *See* 1987 Specification, p. 25-26. Likewise, the term "instruction signal" is used in the WSW example in the 1981 specification. As the following chart demonstrates, the instruction signals used in the 1987 Wall Street Week example are disclosed in a very similar manner as the "instruction signals" disclosed in the 1981 specification:

1981 Specification	1987 Specification
Microcomputer, 205, is preprogrammed to respond in a predetermined fashion to instruction signals embedded in the "Wall Street Week" programing transmission. . . .	Microcomputer, 205, is preprogrammed to receive said input of signals at its asynchronous communications adapter and to respond in a predetermined fashion to instruction signals embedded in the "Wall Street Week" programming transmission. . . .
Then the host says, "And here is what your portfolio did." At this point, an instruction signal is generated in the television studio originating the programing and is transmitted in the programing transmission. This signal is identified by decoder, 203, and transferred via processor, 204, to microcomputer, 205.	Then the host says, "And here is what your portfolio did." At this point, an instruction signal is generated at said program originating studio, embedded in the programming transmission, and transmitted. Said signal is identified by decoder, 203; transferred to microcomputer, 205; and executed by microcomputer, 205, at the system level as the statement, "GRAPHICS ON".
This signal instructs microcomputer, 205, to transmit the first overlay to TV set, 202, for as long as it receives the same instruction signal from processor, 204. The viewer then sees a microcomputer generated graphic of his own stocks' performance overlay the studio generated graphic. (Col. 19, line 7 - Col. 20, line 7.)	Said signal instructs microcomputer, 205, at the PC-MicroKey 1300 to overlay the graphic information in its graphics card onto the received composite video information and transmit the combined information to TV monitor, 202M. TV monitor, 202M, then displays the image shown in Fig. 1C which is the microcomputer generated graphic of the subscriber's own portfolio performance overlaid on the studio generated graphic. (P. 21, ll. 20-24; P. 25, l. 33 - P. 26, l. 11.)

Applicants' use of the term "instruction signal" in both specifications, as reflected in the above chart, is consistent. Further, the above chart clearly demonstrates that both specifications disclose instruction signals that are not "computer software/programming," as the Examiner uses that term. *See also* Declaration of Dr. Ligler, ¶¶ 40 and 49. The Examiner's position, on the other hand, is wholly unsupported. Moreover, the Examiner fails to discuss the term in the context of any pending claim.

(c) Signal Word

In Section I (V) (3) of the Office action, the Examiner asserts that applicants use the term "signal word" inconsistently in the 1981 and 1987 specifications. Despite the Examiner's assertions, applicants' use of the term "signal word" in the 1987 specification is not inconsistent with applicants' use and definition of that term in the 1981 specification. As acknowledged by the Examiner, applicants carried forward the identical definitions of "signal word" (and the term "signal unit") from the 1981 specification into the 1987 specification. Despite the fact that the term "signal word" is defined identically in both specifications, the Examiner argues that applicants use the term in a manner that is "inconsistent" and repugnant" to its definition.

The term "signal word" is defined in both specification as follows:

The term "signal word" hereinafter means one full discrete appearance of a signal as embedded at one time in one location on a transmission. Examples of signal words are a string of one or more digital data bits encoded together on a single line of video or sequentially in audio. Such strings may or may not have predetermined data bits to identify the beginnings and ends of words. Signal words may contain parts of signal units, whole signal units, or groups of partial or whole signal units or combinations.

1981 Specification, col. 3, ll. 3-12; 1987 Specification, p. 14, l. 32 - p. 15, l. 6. The Examiner asserts without support or explanation that the term signal word is used throughout the 1987 specification in a manner inconsistent with its definition to refer to "the N-bit bytes of 'computer-type' data which make up the digital information that is

now distributed and/or processed by the 1987 inventions.” Office action, p. 39. The Examiner asserts that although the term “signal word” is defined in the 1987 specification to refer to “each occurrence/appearance of ancillary signaling within the distributed TV/Radio/Other programming” the term is actually used in the 1987 specification to refer to “the ‘words’/bytes of digital computer-type data which comprise (and do not carry) said ancillary signaling.” *Id.*

Applicants do not fully understand the Examiner’s argument. Applicants’ use of “signal word” throughout the 1987 specification is consistent with its definition. Applicants defined the term “signal word” broadly to include many different types of signals. The definition states that “signal words may contain parts of signal units, whole signal units, or groups of partial or whole signal units or combinations.” Applicants’ use of the term “signal word” in connection with data (computer type or otherwise) of a certain bit length is not inconsistent with this definition. The definition of “signal word” is in no way limited to preclude applicants use of the term in connection with the “N-bit bytes of computer type data.” The Examiner provides no argument, justification or reason whatsoever to support his opinion that applicants’ definition of “signal word” is inconsistent with this usage. Further, there is no reason why a person of ordinary skill in the art would not understand that applicants’ definitions of signal words and signal units are applicable to the SPAM messaging protocol disclosed in the 1987 specification. *See* Declaration of Dr. Ligler, ¶ 50.

Finally, applicants firmly dispute the following allegation made by the Examiner:

via slight of hand, the alleged meaning of the “signal word” terminology was quickly changed within the instant 1987 disclosure so as to refer to the “words”/bytes of digital computer-type data which comprise (and did not carry) said ancillary signaling

Office action, p. 39. This accusation is grossly inappropriate, and quite obviously, wholly unsupported. As applicants have explained above, they have not used the term

“signal word” in a manner that is inconsistent with its definition in the 1987 specification. The Examiner fails to even suggest anything that would motivate applicants to engage in “slight of hand” when preparing their 1987 specification. Accordingly, this allegation, and any rejection or objection based thereon, should be promptly withdrawn.

(d) The “SPAM” Transport Scheme vs. The 1981 Signaling Transport Scheme

In Section I (V) (5) of the Office action, the Examiner asserts that the “SPAM transport scheme” disclosed by applicants in their 1987 specification is inconsistent with the signaling transport scheme disclosed in the 1981 specification. First, applicants dispute the Examiner’s characterization of the SPAM messaging scheme disclosed by applicants in their 1987 specification.

Applicants acknowledge that the 1987 specification discloses new ways for embedding signals in transmissions that were not disclosed in 1981. Applicants maintain, however, that the two specifications are consistent with respect to this issue. Certainly, both specifications contain the common disclosure of embedding signals in transmissions that are sent and then received at receiver stations where the signals are removed (i.e., stripped out) and processed. As long as applicants do not claim or include limitations of the specific enhancements/improvements disclosed in 1987, there is no reason why both disclosures cannot support claims simply reciting that signals are embedded, transmitted, and processed (along with other features disclosed in both specifications). Accordingly, the Examiner is incorrect in making the conclusory statement that “all of the currently pending amended claims have at least one limitation whose scope and meaning is defined by 1987 ‘SPAM’ signaling . . . none of the claims are entitled to the 1981 priority date of the parent disclosure which did not describe SPAM.” Office action, p. 42-43. As applicants have already explained, it is simply improper for the Examiner to read

limitations of the enhanced and improved SPAM signaling scheme into claims that do not include any such limitations. A proper determination as to whether a specific claim is supported under § 112 can only be made by focusing on the specific limitations that actually exist in that claim. Applicants submit that if their claims are addressed on a claim by claim basis, one will conclude that both specifications provide adequate written description support. *See* Declaration of Dr. Ligler, ¶ 53.

(3) Inherency

In Section I (V) (4) of the Office action, the Examiner requests applicants to identify all teachings from each specification that are inherently disclosed in the other specification. Applicants are aware of no authority that would obligate them to respond to this heretofor unheard of request. Of course, both specifications are and have been before the Examiner and are therefore available for any legitimate examining activity. To the extent that applicants need to rely on an inherent feature or features that exists in either disclosure to overcome a rejection or objection by the Examiner, applicants reserve the right to identify such inherent teachings in response to such a rejection.

In Section I (V) (4) of the Office action, the Examiner also challenges applicants' use of the term "implicitly" in their Response to the Examiner's 8/28/01 Office action. Specifically, the Examiner asserts, again without support, that:

what might have been "implicitly" taught in the past 1981
parent specification is irrelevant to section 112-1 support
issues

[and]

The fact that the 1987 feature . . . was "implicitly" there is
insufficient to establish something as being 'inherent'

Office action, p. 40-41. The Examiner's position is directly contradicted by the instructions in the M.P.E.P. on this issue:

While there is no *in haec verba* requirement, newly
added claim limitations must be supported in the

specification through express, implicit, or inherent disclosure.

M.P.E.P. § 2163 (I) (B).

To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure.

M.P.E.P. § 2163 (II) (A) (3) (b). Accordingly, the Examiner's assertion that applicants had improperly invoked the term "implicitly" is without merit.

(4) The Wall Street Week Example

In Section I (V) (6), the Examiner asserts that while the Wall Street Week ("WSW") examples described in both specifications "have their similarities, the actual methods/details/structures used to carry out these two Wall Street Week embodiments are quite different." Office action, p. 43. The Examiner goes on to discuss alleged differences and then concludes that it would be "improper" to give claims directed to WSW a 1981 priority date "unless it can show that the support that is provided for the claims by both disclosures is in fact the same/common to both disclosures." Office action, p. 46. The Examiner's assertion is wrong for several reasons.

In his discussion of the WSW examples, the Examiner identifies two alleged differences between how the example is disclosed in both specifications. The Examiner asserts that the "microcomputer (205)" in both specifications is different. The microcomputer from applicants' 1987 specification is alleged to have "circuitry" for: 1) overlaying locally generated graphics over the TV signal broadcast, and 2) receiving, loading, and running downloaded computer software. In contrast, the Examiner alleges that the microcomputer disclosed in the 1981 specification: 1) lacks such overlaying circuitry, and 2) is preprogrammed with computer software to execute functions defined by received discrete instructions.

Applicants submit that the Examiner's is incorrect with respect to these two aspects of how the microcomputer functions in the two WSW examples. First, the Examiner fails to identify any actual differences in the circuitry of microcomputer 205 with respect to the overlaying of locally generated graphics as evidenced by the disclosures. Instead, the Examiner makes sweeping and wholly unsupported allegations that the "elements" of the "structures" related to microcomputer, 205 disclosed in applicants' 1981 and 1987 specifications are "clearly different in both structure and operation" and:

showing that, as with applicant's use of common terminology, it would be erroneous for one to assume that common labels and common reference numerals were used in applicant's 1981 and 1987 disclosures as an indication of common elements or "common subject matter".

Office action, p. 44 (emphasis in original). Contrary to the Examiner's assertion, applicants respectfully submit that applicants' use of common terms and common numerals strongly suggests that there is, in fact, substantial overlapping subject matter in the two specifications. *See, e.g.*, Declaration of Dr. Ligler, ¶¶ 43-57. Any differences do not impact the conclusion that both specifications support the pending claims. *See* Declaration of Dr. Ligler, ¶ 57. Second, while the WSW example disclosed in 1987 is capable of receiving programming that can be downloaded and run at microcomputer 205, the 1987 specification also indicates that microcomputer (like the microcomputer 205 in the 1981 specification) contains preprogramming. *See, e.g.*, 1987 specification, p. 14, ll. 15-22.

Applicants submit that the Examiner's discussion of the two WSW examples exaggerates any differences between the two examples in 1981 and 1987 specifications. Moreover, the Examiner fails to address the substantial similarities between the two Wall Street Week examples. Applicants maintain that all of the pending claims can be

supported by those features and teachings of the 1981 WSW example that are also found in the 1987 example.

**(5) All Recitations Directed To
“Signals/Instructions/Data”
Conveyed In TV Transmissions
Derive Support From SPAM
Signaling First Disclosed In 1987**

In Section I (V) (7) of the Office action, the Examiner asserts that applicants’ claim to a 1981 priority date is “refuted” because applicants claims “derive their required Section 112 support from the ‘SPAM’ signaling” that was not introduced until the 1987 specification was filed. Office action, p. 46-47. The Examiner is incorrect. As applicants have already stated, details related to the SPAM signaling structure that are not found in the 1981 specification need not, and indeed should not, be improperly read into applicants’ pending claims. All of applicants’ pending amended claims are adequately supported by both specifications, and details related to the SPAM signaling protocol that are not recited in applicants’ claims have no bearing on the fact that applicants’ claims are adequately supported by both specifications. *See* Declaration of Dr. Ligler, ¶ 53.

**(6) Differences Related To How
Receiver Stations Are
Programmed In The Two
Specifications**

In Section I (V) (7) of the Office action, the Examiner argues that the receiver stations disclosed in applicants’ 1981 and 1987 specifications differed in that the receiver station disclosed in the 1987 specification could be reprogrammed “on the fly,” while the receiver station disclosed in the 1981 specification could not. First, applicants note that the Examiner does not make a rejection or objection in connection with the arguments made in Section I (V) (7) of the Office action. Second, the 1981 specification clearly discloses reprogramming the receiver station via receipt of a remote transmission over a telephone connection. *See* 1981 Specification, col. 9, ll. 21-22; *see also* Declaration of

Dr. Ligler, ¶ 52. Finally, applicants note that the alleged differences between applicants' two specifications discussed in Section I (V) (7) of the Office action do not alter the fact that both specifications support the claimed subject matter. *See* Declaration of Dr. Ligler, ¶ 52.

(7) The Examiner's Position On Best Mode Issues

In Section I (V) (8) of the Office action, the Examiner presents an abridged version of his "best mode" based test for denying applicants' priority claim. Applicants responded to the Examiner's arguments concerning these best mode issues in detail in their 5/06/02 Response to Interview Summary. The Examiner has not acknowledged or responded to applicants' discussion of these issues. The Examiner appears to acknowledge that the Federal Circuit's holding in *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994) does not support his position, however, applicants' cannot determine whether or not the Examiner's position has changed on the overall issue. Applicants respectfully request that the Examiner specifically respond to applicants' arguments on this issue, or withdraw the "best mode" based test for denying applicants' priority claim in its entirety.

k. Arguments Related To Claims In A Copending Application Previously Reciting The Term "Interactive Video"

In Section II (1) of the Office action, the Examiner raises issues regarding applicants' use of the term "interactive video." Section II (1) of the Office action responds to issues pertinent to the '571 application. In the '571 application, applicants' responded to a rejection made by the Examiner in his 8/28/01 Office action concerning a claim that previously recited the term "interactive video." In applicants' 1/28/02 Response filed in the '571 application, applicants noted that although they disputed the Examiner's basis for rejecting the relevant claim, they had nevertheless deleted the

limitation “interactive” from the claim. Notwithstanding the lack of relevance of this issue to the instant application, applicants maintain that both the 1981 and 1987 specifications unquestionably disclose “interactive video apparatus.” *See, e.g.*, 1981 Specification col. 20, ll. 23-27, and “Local Input” in Figure 6D; 1987 Specification, p. 288, ll. 1-20. The term “interactive video” still does not appear in any of applicants’ pending amended claims, and the issues raised by the Examiner in Section II (1) of the Office action are therefore moot. If and when the issues raised in Section II (1) of the Office action are germane to this application or any of applicants’ other copending applications, applicants will respond further to the issues raised in Section II (1) of the Office action.

I. The Examiner’s Characterization (And Applicants’ Alleged Misunderstanding) Of Teletext

In Section II (2) of the Office action, the Examiner discusses his characterization of “standardized” Teletext and certain arguments advanced by applicants in their prior responses to certain prior art rejections made by the Examiner in his 9/04/01 Office action. Applicants fully address the issues raised in Section II (2) of the Office action in their discussion of the Examiner’s prior art rejections below.

5. Response To The 30 Examples

In Section IV of the Office action, the Examiner lists of 30 “Examples” discussing issues related to applicants’ compliance with §§ 112 and 120. The vast majority of the 30 Examples are simply verbatim duplicates of text that the Examiner has copied from earlier sections of the two most recent Office actions. Seven (7) of the Examples (Examples 1, 2, 3, 12, 15, 16, and 20) are copied from earlier sections of the 7/30/02 Office action. Nineteen (19) other Examples (Examples 4, 6-11, 13, 14, 17, 18, and 22-29) are copied from the Examiner’s 9/04/01 Office action in the instant application. Of the 30 Examples, only four (4) Examples present any “new” discussion of §§ 112/120

issues, and even these four Examples simply rehash arguments that have been advanced by the Examiner elsewhere.

At the beginning of Section IV, the Examiner alleges that in some cases applicants have “handled and addressed” these issues inconsistently in different applications. The Examiner states that the list of “Examples” will be maintained by the Patent Office “in an attempt to ensure consistency in the way that these issues are handled between applications in the future.” Office action, p. 56. Many of the issues discussed in the 30 Examples have been raised by the Examiner before in different forms in some of applicants’ various copending applications. In addressing such issues, applicants have at all times strived to address these reoccurring issues in a consistent manner in all of applicants copending applications. Applicants’ position on their ability to demonstrate that their pending claims can be supported under § 112 and their assertion that many of their claims are entitled to priority under § 120 have not changed. Further, applicants’ position with respect to what the law requires for applicants to satisfy §§ 112 and 120 has also not changed. Accordingly, applicants believe that the Examiner is mistaken in his unsupported assertion that applicants have “handled and addressed” the issues raised in the 30 Examples “inconsistently.”

Applicants also question the relevance of the 30 examples, as well as applicants’ need to respond to these examples, because none of the examples forms the basis for any objection or rejection of a pending claim. *See* 37 C.F.R. § 1.111(b) (2001) (“In order to be entitled to reconsideration or further examination, the applicant . . . must reply to every ground of objection and rejection in the prior Office action.”). Accordingly, all 30 Examples should be withdrawn in their entirety. Applicants reserve their right to further address any issue raised in the 30 Examples if the Examiner makes an actual rejection or objection based on any of the issues raised in the Examples.

Example 1

Example 1 is substantially identical to Section III (1) of the 7/30/02 Office action, which applicants have responded to above.

Example 2

Example 2 is substantially identical to the final part of Section I (A) of the 7/30/02 Office action, which applicants have responded to above.

Example 3

Example 3 is substantially identical to Section III (2) of the 7/30/02 Office action, which applicants have responded to above.

Example 4

Example 4, is substantially identical to Section II (1) of the 9/04/01 Office action in the instant application. Applicants have already fully responded to the issues raised in Example 4 in their 2/04/02 Response. The Examiner does not indicate that he has considered applicants' response to the issues raised in Example 4. In addition to applicants' prior response to the issues raised in Example 4, applicants address the "locally generating" issue in detail below. Applicants continue to respectfully disagree with the Examiner's assertion that Teletext decoders locally generate images for output or display in the same manner as being claimed in the instant application.

Example 5

In Example 5, the Examiner asserts that applicants' 1987 "packetized SPAM" structure represents little more than applicants' own version of a "conventional extended Teletext system." The issues discussed in Example 5 are not discussed in the context of any of the claims currently pending in the instant application and the Examiner does not reject any of the pending claims based on the assertions made in Examples 5. If and when the Examiner makes rejections of specific pending claims on the basis of issues raised in Example 5, applicants will further respond to such rejections. Notwithstanding

the lack of any rejection in Example 5, applicants strenuously disagree with the Examiner's disparaging assertions and characterizations of the subject matter disclosed in applicants' 1987 specification. Applicants note that they have previously addressed how applicants' claims differ from many "Teletext" prior art references in their prior responses in the instant application, and applicants further distinguish the currently pending claims from "Teletext" prior art references below.

Example 6

Example 6 is substantially identical to Section II (2) of the 9/04/01 Office action in the instant application. Applicants have already fully responded to the issues raised in Example 6 in their 2/04/02 Response. The Examiner does not indicate that he has considered applicants' response to the issues raised in Example 6. In addition to applicants' prior response to the issues raised in Example 6, applicants address the "computer software/programming" issue in detail above. Applicants continue to respectfully disagree with the Examiner's assertions regarding the "computer software/programming" issue. Finally, applicants note that none of applicants' currently pending claims use the terms "computer software" or "programming." *See also* Declaration of Dr. Ligler, ¶¶ 44-47.

Example 7

Example 7 is substantially identical to Section II (3) of the 9/04/01 Office action in the instant application. Applicants have already fully responded to the issues raised in Example 7 in their 2/04/02 Response. The Examiner does not indicate that he has considered applicants' response to the issues raised in Example 7. Applicants continue to respectfully disagree with the Examiner's assertions and characterizations of Teletext decoders found in the prior art and the signal processor disclosed by applicants. Applicants submit that the signal processors disclosed in applicants' specifications perform functions that are not disclosed in the cited Teletext prior art references. Further,

applicants note that the Examiner does not make any rejections of or objections to any of applicants' pending claims in Example 7.

Example 8

Example 8 is substantially identical to Section II (4) of the 9/04/01 Office action in the instant application. Applicants have already fully responded to the issues raised in Example 8 in their 2/04/02 Response. The Examiner does not indicate that he has considered applicants' response to the issues raised in Example 8. In Example 8, the Examiner asserts that it is applicants' position that applicants' claimed/disclosed technology is not "correlated/analogous" to Teletext technology. The Examiner, however, fails to provide any details regarding his position that "conventional Teletext systems" generally are correlated or similar to applicants' claimed technology. Indeed, such generalized "correlations" or "analogies" are wholly irrelevant to the issue of whether or not applicants' claims are patentable. Applicants' position is that none of the cited references, related to Teletext or otherwise, alone or in combination, teach the methods and apparatus claimed by applicants. Applicants further distinguish the currently pending claims from so-called "conventional Teletext systems/technology" below.

The Examiner further argues that applicants have indicated it is their belief that the scope of many of their pending claims encompasses the "Weather Star" system/receiver technology. First, the question of whether or not a particular system would be covered by a pending claim is wholly irrelevant to the examination of the instant claims, unless such system is prior art. The Examiner has not established that the Weather Star system is prior art. Second, although the Examiner vaguely refers to applicants' "pending amended claims," he makes no reference to a specific application or a specific claim. Due to the Examiner's broad treatment of these issues, applicants cannot further respond in any meaningful manner to the issues raised in Example 8.

Example 9

Example 9 is substantially identical to Section II (5) of the 9/04/01 Office action in the instant application. In Example 9, the Examiner discusses the issue of whether “digital television signals/programming” was well known in the relevant art at the time that applicants filed their specifications. In their 2/04/02 Response, applicants fully addressed the Examiner’s rejections under § 112, second paragraph, of claims with limitations of “digital television,” and applicants maintain their previously stated position regarding the Schwartz et al. reference. None of applicants’ currently pending amended claims recite the limitation “digital television.” Further, only one claim, claim 63, recites the term “digital,” in the context of the communication of a video apparatus with a remote data source “via a digital information channel.” Applicants do not use the term “digital” in claim 63 in a manner believed to be objectionable by the Examiner. Accordingly, the issues raised in Example 9 are moot. Applicants note that there are no rejections of or objections to any of applicants pending claims based on the issues raised in Example 9, and applicants reserve the right to further respond to the issues raised in Example 9 if any of these assertions are relied on to object to or reject any claim in the future.

Example 10

Example 10 is substantially identical to Section II (6) of the 9/04/01 Office action in the instant application. Applicants have already fully responded to the issues raised in Example 10 in their 2/04/02 Response. The Examiner does not indicate that he has considered applicants’ response to the issues raised in Example 10.

In Example 10, the Examiner discusses two references issued to Zaboklicki: DE 2,914,981 and GB#2,016,874. Despite the Examiner’s characterization of applicants’ arguments regarding these references, applicants continue to maintain that neither Zaboklicki reference anticipates or renders obvious any of applicants’ pending claims.

Applicants will continue to address in detail any rejection under § 102 or § 103 in which a Zaboklicki reference is applied.

Examples 11 and 12

Examples 11 and 12 are substantially identical to sections of Section II (7) of the 9/04/01 Office action and Section I (N) of the 7/30/02 Office action, respectively. Applicants have already fully responded to the “programming” issues raised in Examples 11 and 12 in their 2/04/02 Response and their Response to Interview Summary. In addition to applicants’ prior responses to the “programming” issues, applicants further address this issue in detail above. *See also* Declaration of Dr. Ligler, ¶¶ 44-47.

Example 13

Example 13 is substantially identical to Section II (8) of the 9/04/01 Office action in the instant application. In Example 13, the Examiner discusses whether or not radio and television arts represent non-analogous arts. The Examiner states that applicants have previously asserted that the radio and television arts are non-analogous arts. The Examiner’s assertions in Example 13 do not form the bases for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 13 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim.

Example 14

Example 14, discussing the “simultaneous and sequential” claim recitation, is substantially identical to Section II (9) of the 9/04/01 Office action in the instant application. Applicants have already fully responded to the issues raised in Example 14 in their 2/04/02 Response. The Examiner does not indicate that he has considered applicants’ response to the issues raised in Example 14. Further, the Examiner’s

assertions in Example 14 do not form the bases for any rejection of or objection to any specific claim pending in the instant application.

Examples 15 and 16

Examples 15 and 16 are substantially identical to Section I (P) and (Q), respectively, of the 7/30/02 Office action. Applicants have already fully responded to the “programming” issue raised by the Examiner in their 2/04/02 Response and their Response to Interview Summary. In addition to applicants’ prior responses to the “programming” issues, applicants further address this issue in detail above. *See also* Declaration of Dr. Ligler, ¶¶ 44-47.

Examples 17, 18, 23, 24, 25, and 26

Examples 17, 18, 23, 24, 25, and 26 are substantially identical to Sections II (10), (11), (15), (16), (17), and (18), respectively, of the 9/04/01 Office action in the instant application. Examples 17, 18, 23, 24, 25, and 26 discuss various issues related to applicants’ ability to obtain a priority date based on their 1981 specification and the proper legal test to be applied when analyzing an applicant’s ability to obtain a priority date under § 120. Applicants have already fully responded to the issues raised in Examples 17, 18, 23, 24, 25, and 26 in detail in their 2/04/02 Response and their Response to Interview Summary. The Examiner does not indicate that he has considered applicants’ response to the issues raised in Example 17, 18, 23, 24, 25, and 26. In addition to applicants’ prior response to the issues raised in Examples 17, 18, 23, 24, 25, and 26, applicants further address those issues in detail above.

Example 19

In Example 19, the Examiner asserts that applicants’ have not demonstrated that their pending claims are supported by “common subject matter.” Applicants have already fully responded to the “common subject matter” issue raised in Example 19 in their 2/04/02 Response and their Response to Interview Summary. In addition to

applicants' prior responses to the "common subject matter" issue, applicants further address this issue in detail above. Applicants further note that the allegation that applicants support claim 123 pending in the '571 application with the Wall Street Week example from the 1981 specification and with the Super Discount Supermarket example from the 1987 specification, fails to take into account applicants' narrative summaries for claim 123 submitted by applicants in their 1/28/02 Response filed in the '571 application. In the narrative summary submitted by applicants in the '571 application regarding how claim 123 is supported under § 112, first paragraph, by both specifications, applicants rely only on the Wall Street Week example disclosed in both specifications. In any event, applicants have cancelled claim 123 in the '571 application, therefore the issue is moot.

Example 20

Example 20 is substantially identical to Section I (I) of the 7/30/02 Office action, which applicants have responded to above.

Example 21

In Example 21, the Examiner describes and compares the technology disclosed by applicants in their 1981 and 1987 specifications and asserts that the technology disclosed in applicants' two specifications is "vastly different." While it is true that the 1987 application includes many enhancements and improvements, applicants maintain that the subject matter disclosed in their 1981 application is also disclosed in the 1987 application. Applicants have further addressed the issues raised in Example 21 in greater detail above.

Example 22

Example 22, regarding applicants' alleged inconsistent use of terminology, is substantially identical to Section II (14) of the 9/04/01 Office action in the instant application. Applicants have already fully responded to the issues raised in Example 22

in their 2/04/02 Response. The Examiner does not indicate that he has considered applicants' response to the issues raised in Example 22. In addition to applicants' prior response to the issues raised in Example 22, applicants further address these issues above.

Example 27

Example 27 is substantially identical to Section II (19) of the 9/04/01 Office action in the instant application. In Example 27, the Examiner asserts that certain structures recited in some of applicants' claims (namely, a receiver, a signal detector, a processor, and an output device) are also "found within a conventional CPU/MP/computer implemented Teletext" receiver. Office action, p. 93. The example is not discussed in the context of any of the claims pending in the instant application and the Examiner does not reject any of the pending claims based on the arguments made in Example 27. If and when the Examiner makes rejections of specific pending claims on the basis of issues raised in Example 27, applicants will further respond to such rejections. Applicants further respond above to the Examiner's assertion that applicants' "'SPAM' is, for all intents and purposes, synonymous with conventional 'Extended Teletext.'" *Id.*

Example 28

Example 28, addressing applicants' disclosure of "interactive" features at receiver stations, is substantially identical to Section II (20) of the 9/04/01 Office action in the instant application. In Example 28, the Examiner questions applicants' written description support for the recitation "interactive ultimate receiver station" previously appearing in claim 56 of the '571 application. None of applicants pending claims in the instant application includes the limitation "interactive." Applicants maintain that both the 1981 and 1987 specifications unquestionably disclose "interactive receiver stations." *See, e.g.*, 1981 Specification col. 20, ll. 23-27, and "Local Input" in Figure 6D; 1987 Specification, p. 288, ll. 1-20.

Example 29

Example 29, discussing limitations allegedly directed to combining images through “replacing” portions of the images, is substantially identical to Section II (21) of the 8/27/01 Office action in the instant application. The issue raised in Example 29 is not relevant to claims pending in the instant case. Applicants have, however, fully responded to these issues in their 1/28/02 and 1/09/03 Responses filed in the ‘571 application.

Example 30

In Example 30, the Examiner discusses the publication date of an article/reference by Gunn et al. Applicants acknowledge that the Gunn reference refers to a conference in London that took place from March 26-28, 1980. But this information alone does not qualify the reference as prior art (i.e., it was unclear when the paper was published). However, since the mailing of the 7/30/02 Office action, applicants received a copy of the Gunn reference that bears a Massachusetts Institute of Technology (“MIT”) Library received stamp dated December 4, 1980. The Examiner also alleges in Example 30 that applicants have previously neglected to provide the Office with information regarding the publication dates of many references. Applicants have diligently supplied the Office with references as they have become known to applicants. In some instances, dates were not provided with certain references, so applicants were not able to provide the Office with dates for each and every reference identified on some of applicants’ Information Disclosure Statements.

C. Response To Rejections Under Section 112, Second Paragraph

In Section V of the Office action, claim 45-49 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The cancellation of claims 45-49 renders these rejections moot.

D. Response To Rejections Under Section 112, First Paragraph

In Section VI of the Office action, the Examiner rejects applicants claims 2-18, 20-30, 33-49, and 51-60, under § 112, first paragraph, as containing subject matter which was not sufficiently disclosed in applicants' specification. Applicants respectfully submit that the Declaration of Dr. Ligler filed herewith demonstrates that the instant specification, as well as applicants' 1981 specification, each provide support for all of applicants' pending claims, as amended, as required by 35 U.S.C. § 112.

In Sections VI (F), (G), (H), (O), (P), (Q), (S), (U), (V), and (A2), the Examiner requests clarification as to where certain recitations appearing in claims 7, 8, 9, 21, 22, 23, 25, 27, 28, and 35 are described in applicants' originally filed disclosure. Applicants' proposed claim amendments have rendered moot the Examiner's concerns in these sections with regard to written description support for certain recitations previously appearing in these claims. The Declaration of Dr. Ligler shows where support may be found in both specifications for new recitations in the claims. In Sections VI (H2) through (V2), the Examiner requests clarification as to where certain recitations of claims 43-49 and claims 51-60 are described in applicants' originally filed disclosure. As applicants' have canceled claims 43-60, the Examiner's concerns with regard to written description support for these claims are also moot.

In Section VI (A) the Examiner requests clarification as to where certain recitations of claim 2 are described in applicants' originally filed disclosure. Applicants' proposed claim amendments have rendered moot the Examiner's concerns in parts 5, 9 and 10 of Section VI (A). With regard to written description support for the recitations identified in parts 1-4, 6-8, and 11-13 of Section VI (A), Paragraphs 21-27 of the Declaration of Dr. Ligler demonstrate where support exists in both specifications for the identified recitations.

In Sections VI (B), (C), (D), (E), (I), (J), (K), and (L) the Examiner requests clarification as to where certain recitations of claims 3, 4, 5, 6, 11, 12, 13, 14, 15, and 16 are described in applicants' originally filed disclosure. Written description support for the identified recitations in those claims is set forth in Tab F of Dr. Ligler's Declaration.

In Section VI (M) the Examiner requests clarification as to where certain recitations of claims 17 and 18 are described in applicants' originally filed disclosure. Written description support for these recitations are addressed in Tab F of Dr. Ligler's Declaration. Applicants' proposed claim amendments have rendered moot the Examiner's concerns with regard to written description support for the recitations previously appearing in claim 18.

In Section VI (N) the Examiner requests clarification as to where certain recitations of claim 20 are described in applicants' originally filed disclosure. The Examiner's concerns in Sections VI (N)(1)-(5) are addressed in Paragraph 36 of Dr. Ligler's Declaration. Applicants' proposed claim amendments have rendered moot the Examiner's concerns in Sections VI (N)(6)-(8).

In Section VI (R) the Examiner requests clarification as to where certain recitations of claim 24 are described in applicants' originally filed disclosure. The Examiner's concerns in Sections VI (R)(1) and (4) are addressed in Paragraph 37 of Dr. Ligler's Declaration. Applicants' proposed claim amendments have rendered moot the Examiner's concerns in Sections VI(R)(2), (3), (5) and (6).

In Section VI (T) the Examiner requests clarification as to where certain recitations of claim 26 are described in applicants' originally filed disclosure. The Examiner's concerns in Sections VI (T)(1)-(5) are addressed in Paragraph 38 of Dr. Ligler's Declaration. Applicants' proposed claim amendments have rendered moot the Examiner's concern in Section VI (T)(6).

In Section VI (W) the Examiner requests clarification as to where certain recitations of claim 29 are described in applicants' originally filed disclosure. The

Examiner's concerns in Sections VI (W)(1), (5), and (6) are addressed in Paragraph 39 of Dr. Ligler's Declaration. Applicants' proposed claim amendments have rendered moot the Examiner's concerns in Sections VI (W)(2)-(4).

In Section VI (X) the Examiner requests clarification as to where certain recitations of claim 30 are described in applicants' originally filed disclosure. The Examiner's concerns with regard to written description support for claim 30 are addressed in Tab F of Dr. Ligler's Declaration. *See also* Declaration of Dr. Ligler, ¶¶ 21-27, and 39.

In Section VI (Y) the Examiner requests clarification as to where certain recitations of claim 33 are described in applicants' originally filed disclosure. Applicants' proposed claim amendments have rendered moot the Examiner's concerns in parts 4 and 5 of Section VI (Y). With regard to the Examiner's concerns in parts 1-3, and 6 of Section VI (Y), Paragraphs 28-35 of the Declaration of Dr. Ligler demonstrate where support exists in both specifications for the identified recitations.

In Section VI (Z) the Examiner requests clarification as to where certain recitations of claims 34 and 36 are described in applicants' originally filed disclosure. These concerns are addressed in Tab F of Dr. Ligler's Declaration.

In Section VI (B2) the Examiner requests clarification as to where certain recitations of claim 37 are described in applicants' originally filed disclosure. Applicants' proposed claim amendments have rendered moot the Examiner's concerns in parts 1-3, 5, and 7-8 of Section VI (B2). With regard to written description support for the recitations identified in parts 4, 6, and 9 of Section VI (B2), Paragraphs 21-27 and Tab F of the Declaration of Dr. Ligler demonstrate where support exists in both specifications for the identified recitations.

In Sections VI (C2)-(G2) the Examiner requests clarification as to where certain recitations of claims 38-42 are described in applicants' originally filed disclosure. The

Examiner's concerns with regard to written description support for the identified recitations in claims 38-42 are addressed in Tab F of Dr. Ligler's Declaration.

E. Response To Prior Art Rejection Of Claims

As an initial matter, applicants note that the Examiner has been unable to uncover a single anticipatory reference for any claim. The Examiner does, however, make numerous rejections of applicants' claims using various combinations of references under 35 U.S.C. § 103. Applicants note that the Examiner also relies on generalized teachings of "conventional" devices exemplified by cited references. For the reasons discussed below, this reliance on generalized teachings is improper. In the few instances where the claims are rejected based on a single reference, the Examiner relies on § 103, not § 102, which further demonstrates that no single reference teaches any of applicants' claims. Applicants address the prior art rejections in detail below.

1. Requirements Of Section 103

To establish a *prima facie* case of obviousness under § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all of the claim recitations. M.P.E.P. § 706.02(j) (8th ed. 2001). Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to support a § 103 rejection based on the modification of a single reference, the Examiner must provide specific evidence to show *why* one of ordinary skill would be motivated to modify the reference in such a way to incorporate all of the claimed elements. *See In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17

(Fed. Cir. 2000) (“Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.”) (emphasis added). Broad conclusory statements concerning motivation to modify, standing alone, are not sufficient to support an obviousness rejection. *See In re Freed*, 425 F.2d 785, 787, 165 USPQ 570, 571-72 (C.C.P.A. 1970) (an obviousness rejection must be based on facts, “cold hard facts”); *In re Kotzab*, 217 F.3d at 1370, 55 USPQ2d at 1317 (“Broad, conclusory statements standing alone are not ‘evidence.’”). Accordingly, a statement that a modification would be an “obvious design choice,” without factual support, is insufficient as a matter of law. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). Finally, as the absence of a suggestion to modify a reference is dispositive in an obviousness determination, a rejection which fails to provide specific evidence as to *why* one of ordinary skill would be motivated to modify the relevant reference is insupportable, as a matter of law. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997).

In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.”). It is well-settled that an Examiner can “satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed.

Cir 2002) (“‘deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). As with rejections based on the modification of a single reference, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 USPQ2d at 1617-18.

As set forth in greater detail below, the Examiner has failed to follow these requirements when making the § 103 rejections of the claims of the instant application. For this reason alone, the § 103 rejections should be withdrawn.

2. Response To Section VII Of The Office Action

Section VII of the Office action contains no rejections of or objections to any of applicants’ claims. Thus, Section VII is not directly relevant to the patentability of applicants’ claims. Accordingly, no response by applicants is required by 37 C.F.R. § 1.111. Nonetheless for completeness and to clarify the record, applicants provide the following comments regarding the assertions made in Section VII. Applicants reserve the right to further respond if any of these assertions are relied on to object to or reject any claim in the future.

Section VII initially asserts that applicants “not only impose[] an unrealistically low level of skill onto section 102 and 103 issues, but applicant effectively places a heavy burden on the examiner to provide an education in what was already well known.” Office action, p. 115. The Examiner then sets forth what *he maintains* is the known operation of teletext as one of ordinary skill in the art would have understood it. It is then

asserted that the signaling structure set forth in applicants' 1987 specification "comprised little more than applicant's own version of conventional packetized Teletext data." Office action, p. 118. Applicants respectfully submit that such disparaging remarks are both unnecessary and improper. Whether or not the Examiner's understanding of teletext bears any resemblance to applicants' disclosed systems is irrelevant. What matters is whether or not *actual prior art* under 35 U.S.C. § 102 may be properly applied to applicants' *claimed inventions*. Applicants maintain that there are substantial elements set forth in the pending claims that are absent from the *actual prior art* for the reasons set forth below in response to Section VIII of the Office action. However, applicants note the following observations regarding the general argument that applicants' signaling structure is little more than teletext.

First, the Examiner expressly states that he is not saying that applicants' own implementation of a signaling structure is necessarily unpatentable because the Examiner may consider it a variant of teletext systems that distribute data in television signals. Office action, p. 119. Applicants maintain that many elements of their claimed invention are not found in any prior descriptions of teletext based systems.

Second, the thrust of the argument in Section VII is that steps of manipulating and organizing discrete signals do not distinguish the claimed invention from the prior art. Applicants maintain that there are novel features of manipulating and organizing discrete signals disclosed in the 1981 and 1987 specifications. However, applicants' claims pending in this application do not rely on or claim these novel features. The presently pending claims in this application do not include limitations specifically directed to manipulating and organizing discrete signals. Each of the instant claims is distinguishable over the applied art for reasons not specifically related to how discrete signals are organized.

Third, the description of teletext relied upon in Section VII is the Examiner's own description, which was written specifically to provide a basis for rejecting applicants'

claims. The Examiner's description of teletext is not in itself prior art. Section VII makes no reference to any prior art teletext references. Rather, Section VII refers to Appendix B of the Office action, which is yet another description of teletext written by the Examiner. Appendix B in turn relies primarily on "the publication contained within 'Appendix A' of this Office action." Office action, p. 173.

Appendix A is titled ["standardized" Teletext (exemplified)] and contains what appears to be a specification for British teletext. Applicants were made aware of the document attached as Appendix A in connection with litigation involving a related patent and, thus, provided it to the Office. The specification is apparently an attachment to a Petition for Rulemaking of the United Kingdom Teletext Industry Group submitted to the Federal Communications Commission on March 18, 1981. There is no evidence of record to establish that the Appendix A document was publicly accessible in a manner that would qualify the document as a printed publication under 35 U.S.C. § 102. If the Examiner considers the document contained in Appendix A to be prior art, then applicants request that the Examiner explain how the document qualifies as prior art. For example, is it asserted to be a printed publication under 35 U.S.C. § 102(a) or (b)? Is it evidence of prior public use under 35 U.S.C. § 102(b)? Applicants note that the Examiner has presented no evidence that Appendix A was sufficiently accessible to the public to qualify as a "printed publication" under § 102. *See, e.g.,* M.P.E.P. § 2128.01 ("While distribution to Government agencies and personnel alone may not constitute publication . . . distribution to commercial companies without restriction on use clearly does." quoting *Garret Corp. v. United States*, 422 F.2d 874, 878, 164 USPQ 521, 524 (Ct. Cl. 1970)). Applicants also note that prior use in the U.K. does not qualify as prior art under 35 U.S.C. § 102(b). Applicants are entitled to know the specific basis for the Examiner's view that the Appendix A document is prior art in order to have a fair and reasonable opportunity to respond. In the absence of any such explanation by the Examiner, applicants submit that the Appendix A document is not prior art. And of

course, the Examiner's characterizations of the Appendix A document, contained in Section VII and Appendix B, also do not qualify as prior art.

Applicants wish to respectfully note that they will not acquiesce in the Examiner's apparent position that "standardized teletext" qualifies as prior art. The Examiner must apply actual prior art under 35 U.S.C. § 102 to the specific claims of the instant application. The Appendix A document has not been established as an available prior art reference. If the Examiner's understanding of "standardized teletext" is based on some assemblage of teletext-based references which qualify as prior art, then a proper claim rejection would be based on the specific references in any such assemblage under 35 U.S.C. § 103. And *each* reference in the assemblage must qualify as prior art under 35 U.S.C. § 102. Of course, applicants will respond to any rejection based on multiple references appropriately. To the extent that the Examiner has taken "official notice" of so called "standardized teletext," applicants hereby request that the Examiner provide specific references to justify that assertion, as required by M.P.E.P. § 2144.03.

Fourth, the Examiners' argument appears to be based on the assumption that applicants' currently pending claims are not entitled to the November 3, 1981 priority date. Applicants maintain for the reasons set forth in detail above that all of the pending claims in the instant application are entitled the benefit of the 1981 priority date. Although not entirely clear from the Office action, the Examiner's description of teletext appears to be the Examiner's understanding of the state of the art prior only to applicants' 1987 priority date. Accordingly, the Examiner's discussion of teletext is of limited value, not only because the Examiner's discussion is not actual prior art, and not only because the claims are distinguishable from the cited teletext references, but also because the instant claims are entitled to the 1981 priority date that may predate the features of teletext described by the Examiner.

For at least these reasons, applicants respectfully submit that Section VII fails to establish any basis for any rejection of the pending claims. It should therefore be withdrawn in its entirety.

3. Summary Of The Prior Art Rejections

Section VIII of the Office action includes 13 lettered parts (designated A-M) each applying a single reference under 35 U.S.C. § 103(a) or a combination of references under 35 U.S.C. § 103(a). Ten references are applied in eight different combinations.

Claims 53 and 57-60 are cancelled. Accordingly, rendered moot is Part C, which rejects claims 53 and 57-60 as being unpatentable over U.S. Patent 4,034,990 to Baer (Baer) in view of U.S. Patent 4,247,106 to Jeffers et al. (Jeffers) and further in view of Teletext's "Telesoftware" as discussed in the publication "TELESOFTWARE- VALUE ADDED TELETEXT" by Hedger.

The rejections of claims 43-49 and 51-60 in parts B, E, H, L and M are rendered moot due to the cancellation of those claims.

Applicants respond to the prior art rejections in detail below.

4. 35 U.S.C. § 103 (a) Rejection Based On Baer In View Of Jeffers

Parts A and B of Section VIII of the Office action rejects claims 2-6, 11-14, 16, 17, 20-24, 26, 29, 30, 37-39, 43-46, 48, 49, 51, 52, and 54-56 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,034,990 issued to Ralph H. Baer (Baer) in view of U.S. Patent 4,247,106 issued to Michael F. Jeffers et al. (Jeffers). The cancellation of claims 43-46, 48, 49, 51, 52 and 54-56 serves to render this rejection moot with respect to these claims.

Baer is directed to an apparatus for playing games on a television receiver. Video signals received by the Baer apparatus have a video background for the game and have active player symbols that have recognizable characteristics allowing circuitry to extract

them from the surrounding video signals so that they can be combined with other signals generated in the viewer's game circuits.

Jeffers is directed to a system to distribute game programs through cable television systems. At the head end an array of game-regulating programs are impressed onto an electronic distribution system, such as serially time division multiplexed onto a game delivery channel. The user sets a game code register to correspond to the desired game. The receiver examines the incoming digits of the game delivery channel for a game identification number corresponding the game code register. Upon finding such a match, the next following sequence of instructions is input into memory of the receiver. The memory of the game controller is loaded with the desired game.

The Office action fails to provide any objective teaching in the prior art that would lead one of ordinary skill to combine the teachings of Baer and Jeffers. The Office action merely states that "such a modification represented nothing less than a known, desirable, and obvious upgrade of technology," (Office action, p. 125) pointing for support to an introductory passage in Jeffers. However, that passage does nothing more than recite Jeffers' understanding of conventional television game technology (e.g., "games...formed of discrete, dedicated, electronics hardware which performed only one game (or, via switches, a switch-selected one of a very limited number of games.)") There is nothing in this passage (or elsewhere) in Jeffers that acknowledges the existence of a game system that includes Baer's improvement, where analog video backgrounds could be used with signals generated by the local game circuitry. Nor does Jeffers in any way suggest that the Baer system could be improved using the teachings of Jeffers. In fact, for the reasons explained below, it is clear that Baer and Jeffers represent different solutions to the common problem at the time of television game inflexibility. A person of ordinary skill in the art would not have combined these teachings.

First, the Examiner is incorrect when he states, "the control circuitry (24) in Baer most likely comprised a software driven computer." There is absolutely no teaching in

Baer of a “computer” or “software,” and not surprisingly, the Examiner has offered no citations to the contrary. Thus, Baer is dealing with systems of the general type mentioned in the cited introductory passage of Jeffers, which used dedicated logic circuitry. To address the inflexibility of such systems, Baer provides the improvement of a “cooperative program source,” which essentially is an encoded, prerecorded analog video signal that is used in connection with the output of the local game circuitry. According to Baer, this “extends the variety and complexity of the games” (col. 1, ll. 59).

In contrast, Jeffers tackles the same problem from a completely different angle. Instead of anything like a “cooperative program source,” Jeffers provides variety and flexibility by distributing game programs to receiver stations using television signals. The subscriber simply identifies the game he/she wants, and the corresponding instruction set of the desired game is loaded into RAM (col. 3, ll. 14-68). Since substantial variety and flexibility is provided through downloading of selected games, there is simply no need for Baer’s improvement, which provides some limited measure of variety and flexibility in the context of dedicated logic-based systems. Moreover, Jeffers makes it clear that games can be “corrected and updated” (not just selected) using the downloading technique (col. 4, ll. 22-24), thus further obviating any need for Baer’s “cooperative program source.”

Finally, Jeffers specifically states that once a game is loaded, the apparatus “functions in the now per se conventional manner to actually implement the selected game in conjunction with a television receiver and player control(s).” (col. 1, ll. 54-56) This plainly counsels against the use of the Jeffers system with Baer’s system, which could hardly be considered conventional at the time.

As the Office action provides no objective evidence of a motivation to combine these references, a *prima facie* case of obviousness has not been established. Indeed, the references teach away from any such combination. For this reason alone, all of the Examiner’s rejections based on Baer and Jeffers should be withdrawn. Additional

reasons why Baer and Jeffers alone or in combination fail to teach or suggest applicants' claimed subject matter are provided below.

a. Independent Claim 2 And Related Claims

Baer in view of Jeffers fails to show or suggest a step of coordinating, under computer control, a presentation using stored information from a first medium with a presentation of a second medium as set forth in claim 2. As noted above, Baer is directed to a video game system including game control circuits. Jeffers is directed to a system for distributing television games.

Claim 2 as amended sets forth a plurality of signals including at least two media. The claimed method includes the step of coordinating, at the receiver station under computer control, a presentation using information from a first medium with a presentation of a second medium. With regard to the first medium, claim 2 sets forth a step of storing the information from the first medium. With regard to the second medium, claim 2 sets forth that the step of coordinating is based on a step of determining content of the second medium. Baer in view of Jeffers fails to suggest the two media used in claim 2. In the Office action, it is suggested that computer gaming "software" of Jeffers constitutes a first medium. Office action, p. 126. Jeffers, however, fails to suggest a second medium. As discussed above, there is no suggestion to combine Jeffers and Baer to arrive at a system that both receives gaming "software" and receives a signal from a "cooperative program source." Furthermore, even if one were to contemplate such a combination, one would not arrive at the claimed use of two media as set forth in claim 2. Even if the game control circuits 24 of Baer were programmed with downloaded "software" of Jeffers (which they cannot be for the reasons discussed above), such downloaded software still fails to meet all the requirements of the first medium set forth in claim 2, because there is no additional suggestion in the applied art of *information* from the "software" that is coordinated with a presentation of a second medium. Baer

does not teach such information from a first medium because Baer fails to teach storing any information from a received medium. Accordingly, Baer and Jeffers, taken individually or in combination, fail to suggest two media as set forth in claim 2.

Claim 2 further sets forth that the presentation using information from the first medium has a predetermined relationship to the content of the second medium. In the Office action, it is asserted that the system of Baer comprised circuitry for coordinating the presentation of locally provided "video graphics data" with presentation of the analog video signal. Baer describes that the "video program contains certain coded data signals representing the positions, identities, sizes or other characteristics of certain elements involved in the game." (col. 2, ll. 24-27) Accordingly, Baer discusses only one medium that includes the video signal and certain coded data. There is no suggestion in Baer of a presentation of information from a first medium having a predetermined relationship to the content of a second medium. Jeffers fails to correct for this deficiency of the primary reference, as Jeffers is silent regarding output of any particular game program.

For at least the above reasons, applicants respectfully request that the 35 U.S.C. §103(a) rejection of amended claim 2 as unpatentable over Baer in view of Jeffers be withdrawn.

Claims 3-6, 11-14, 16 and 17 are rejected as being unpatentable over Baer in view of Jeffers for the same reasons that were set forth for claim 2. These claims depend from claim 2. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. Applicants respectfully request the withdrawal of these rejections of claims 3-6, 11-14, 16 and 17 for at least the above reasons. The following additional distinctions are noted.

Claim 5 sets forth that each of the plurality of signals is received from an external transmitter station. There is no suggestion in either Baer or Jeffers of two media that are received in a plurality of signals each received from an external transmitter station.

Claim 6 as amended sets forth that each of the plurality of signals is received from an intermediate transmitter station. Baer and Jeffers include no suggestion that the received video signal is received from an intermediate transmitter station.

Claim 37 is rejected over Baer in view of Jeffers for the same reasons that were set forth for claim 2. Claim 37 is an apparatus claim that is generally analogous to method claim 2. Claim 37 is amended to set forth a microcomputer that stores information from a first medium and coordinates a presentation using the information with a presentation of a received second medium. Baer in view of Jeffers fails to show this element for the reasons discussed above with respect to claim 2. There is simply no motivation or suggestion to combine Baer and Jeffers to arrive a microcomputer that stores information used to form a presentation and then coordinates a presentation using the information with a presentation of a received second medium.

Claims 38 and 39 are rejected as being unpatentable over Baer in view of Jeffers for the same reasons that were set forth for claim 2. These claims depend from claim 37. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. Applicants respectfully request the withdrawal of these rejections of claims 38 and 39 for at least the above reasons.

New claims 67-69 depending from claim 37 have been added. These claims are patentable over Baer in view of Jeffers for at least the reasons discussed above with regard to the corresponding method claims.

b. Independent Claim 20 And Related Claims

Claim 20 is rejected as being unpatentable over Baer in view of Jeffers for the same reasons as were set forth for claim 2. As the limitations of claim 20 were not addressed within the reasons set forth in the rejection of claim 2, the Office action fails to establish a *prima facie* case of obviousness against claim 20.

Claim 20 as amended sets forth controlling a receiver station to enable a coordinated presentation, through execution of processor instructions, of a first medium and information based on a second medium. Claim 20 is further amended to set forth that the information based on the second medium is generated based on identifying content of the second medium. Baer and Jeffers, taken alone or in combination, fail to show or suggest at least these features of the method of claim 20.

Baer in view of Jeffers fails to show or suggest controlling a receiver station to enable a coordinated presentation, through execution of processor instructions, of a first medium and information based on a second medium. Baer and Jeffers fail to show such a first medium, information based on a second medium, and processor instructions.

Furthermore, claim 20 is amended to set forth that the information based on the second medium is generated based on identifying content of the second medium. Baer and Jeffers include no teaching related to generating information based on identifying content of a second medium.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 20 as unpatentable over Baer in view of Jeffers be withdrawn.

Claims 21-23 are rejected as being unpatentable over Baer in view of Jeffers for the same reasons that were set forth for claim 2. These claims depend from claim 20. Applicants respectfully request the withdrawal of these rejections of claims 21-23 for at least the reasons set forth above with respect to claim 20.

Added are new claims 70-73, which are apparatus claims that are generally analogous to method claims 20-23. Claims 70-73 are patentable over Baer in view of Jeffers for reasons similar to those set forth above with respect to claims 20-23. Claim 70 sets forth a microcomputer for executing processor instructions to enable a coordinated presentation of a first medium and information based on a second medium, wherein said

information based on the second medium is generated based on identifying content of the second medium. Baer and Jeffers fail to show such a microcomputer.

c. Independent Claim 24 And Related Claims

Claim 24 is rejected as being unpatentable over Baer in view of Jeffers for the same reasons as were set forth for claim 2. As the limitations of claim 24 were not addressed within the reasons set forth in the rejection of claim 2, the Office action fails to establish a *prima facie* case of obviousness against claim 24.

Claim 24 is amended to set forth outputting a television program at a first output device and a second medium at a second output device. Baer and Jeffers fail to show or suggest outputting a second medium at a second output device. Claim 24 is also amended to include a step of comparing first information stored at a receiver station to second information corresponding to content of a television program to determine whether to present a second medium based on third information received from a source different from that of said first medium. Baer and Jeffers fail to suggest such a comparison. Baer and Jeffers fail to suggest any determination of whether to make any presentation. Claim 24 is further amended to set forth a step of coordinating presentation of the television program with presentation of the second medium. Baer and Jeffers fail to suggest coordinating presentation of a television program with presentation of a second medium.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 24 as unpatentable over Baer in view of Jeffers be withdrawn.

Added is new claim 103, which depends from claim 24. Claim 103 sets forth that the television program and the third information are included in first and second channels, respectively, of a multichannel cable transmission. Baer and Jeffers fail to

suggest a television program and information forming the basis for a second medium included in channels of a multichannel cable transmission.

Also added are claims 74, 75, and 104, which are apparatus claims that are generally analogous to method claims 24, 25, and 103. Claims 74, 75, and 104 are patentable over Baer in view of Jeffers for reasons similar to those set forth above with respect to claims 24, 25, and 103. Claim 74 sets forth a microcomputer for storing first information, comparing said first information to second information corresponding to content of a television program to determine whether to present a second medium based on third information received from a different source than that of a first medium including the television program, and coordinating presentation, based on the determination, of the television program with presentation of the second medium. Baer and Jeffers fail to show such a microcomputer. Claim 75 sets forth that the second output device comprises a printer. Baer and Jeffers suggest no printer. Claim 104 sets forth that the television program and the third information are included in first and second channels, respectively, of a multichannel cable transmission. Baer and Jeffers fail to suggest a television program and information forming the basis for a second medium included in channels of a multichannel cable transmission.

d. Independent Claim 26 And Related Claims

Claim 26 is rejected as being unpatentable over Baer in view of Jeffers for the same reasons as were set forth for claim 2. As the limitations of claim 26 were not addressed within the reasons set forth in the rejection of claim 2, the Office action fails to establish a *prima facie* case of obviousness against claim 26.

Claim 26 includes the step of receiving, at a receiver station, at least two media from different sources. The application of Baer and Jeffers to this limitation highlights the impropriety of the combination of these references. Baer describes transmitting an analog signal for use with one occurrence of a video game. Jeffers describes

continuously transmitting an ensemble of programs from which a particular game program may be selected. There is no suggestion to combine these references to separately transmit the analog signal and game programs. This is because Baer contemplates that the receiver will include the circuitry required to run the game and Jeffers contemplates that no additional signals are required to execute the game. There is no suggestion regarding how to combine the continuous distribution of an ensemble of game programs of Jeffers with the transmission of the analog signal for use with a single game of Baer. Thus, there is no suggestion for separate transmissions from different sources.

Claim 26 also includes the step of identifying content of a first medium and content of a second medium and the step of outputting a multimedia presentation based on the step of identifying, wherein the multimedia presentation comprises a presentation of information included in the first medium and information based on the second medium. Again, as there is no suggestion in the art as to how to combine the applied references, there is no suggestion to combine Baer and Jeffers so that the analog signal and the game programming are provided in separate media such that that the content of each medium must be identified. There is no further suggestion to output a multimedia presentation of information included in a first medium and information included in a second medium based on identifying content of the media.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 26 as unpatentable over Baer in view of Jeffers be withdrawn.

Added are new claims 82-84, which depend from claim 26. Applicants respectfully submit that these claims are patentable over Baer in view of Jeffers for at least the reasons set forth above with respect to claim 26. In addition, claim 84 sets forth that a plurality of media including the two media is included in a multichannel cable

transmission including a digital data channel including the second medium. Baer in view of Jeffers fails to suggest such a multichannel cable transmission.

Also added are claims 76-81, which are apparatus claims that are analogous in many respects to method claims 26-28, 82, and 83. Claims 76-81 are patentable over Baer in view of Jeffers for reasons similar to those set forth above with respect to claim 26. Claim 76 sets forth a first receiver for receiving a first medium and a second receiver for receiving a second medium. For reasons similar to those discussed above, there is no suggestion to combine Baer and Jeffers to arrive at an apparatus having a first receiver for receiving a first medium and a second receiver for receiving a second medium. Claim 77 sets forth that the microcomputer controls storage of information based on the second medium. Claim 78 sets forth that the microcomputer controls storage of the first medium. Baer and Jeffers fail to suggest a microcomputer controlling storage as set forth in claims 77 and 78. Applicants note that claims 27 and 28 setting forth method steps of storing are not rejected based on Baer in view of Jeffers. Claim 81 sets forth a multichannel cable transmission including the first medium and a digital data channel including the second medium. Baer in view of Jeffers fails to suggest such a multichannel cable transmission.

e. Independent Claim 29 And Related Claims

Claim 29 is rejected as being unpatentable over Baer in view of Jeffers for the same reasons as were set forth for claim 2. As the limitations of claim 29 were not addressed within the reasons set forth in the rejection of claim 2, the Office action fails to establish a *prima facie* case of obviousness against claim 29.

Claim 29 as amended includes the steps of processing a control signal at a receiver station that causes execution of processor instructions to create a series of discrete video images, causing a video image of the series of discrete images to be output, and combining the outputted video image into a multimedia presentation comprising a

first medium. Baer and Jeffers fail to suggest any series of discrete video images and thus fail to suggest these steps related to a series of discrete video images. Baer and Jeffers fail to suggest any control signal related to the creation of a series of discrete video images.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 29 as unpatentable over Baer in view of Jeffers be withdrawn.

Claim 30 is rejected as being unpatentable over Baer in view of Jeffers for the same reasons that were set forth for claim 2. Claim 30 depends from claim 29. Applicants respectfully request the withdrawal of this rejection of claim 30 for at least the reasons set forth above with respect to claim 29.

Added are new claims 91-94, which depend from claim 29. Applicants respectfully submit that these claims are patentable over Baer in view of Jeffers for at least the reasons set forth above with respect to claim 29. In addition, claim 94 sets forth that a multichannel cable transmission includes the first medium including a television program and a digital data channel including the second medium. Baer in view of Jeffers fails to suggest such a multichannel cable transmission.

Also added are claims 85-90, which are apparatus claims that are generally analogous to method claims 29, 30, and 91-94. Claims 85-90 are patentable over Baer in view of Jeffers for reasons similar to those set forth above with respect to claim 29. Claim 85 sets forth a microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal, identifying content of a first medium, and then causing a video image of the series of discrete video images to be output. As discussed above, there is no suggestion in Baer or Jeffers of creating a series of discrete video images based on a control signal. Baer in view of Jeffers, thus, fails to suggest a microcomputer as set forth in claim 85. Claim 90 sets forth that a multichannel cable transmission includes the first medium including a television program

and a digital data channel including the second medium. Baer in view of Jeffers fails to suggest such a multichannel cable transmission.

**5. 35 U.S.C. § 103 (a) Rejection Based On Fukuzaki
In View Of Robinson**

Parts D and E of Section VIII of the Office action rejects claims 2, 3, 5-16, 20-24, 26, 29, 30, 37, 43 and 51-60 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Unexamined Patent Application Publication 56-116385 of Kazuhiro Fukuzaki et al. (Fukuzaki)⁹ in view of the article “ ‘Touch-Tone’ Teletext A Combined Teletext-Viewdata System” by Gary Robinson and William Loveless (Robinson). The cancellation of claims 43 and 51-60 serves to render this rejection moot with respect to these claims.

Fukuzaki is directed to a device that stores successively transmitted character information in a character broadcast receiver. The Fukuzaki device stores multiple screens of character data. Fukuzaki operates in three selectable modes. In a first mode, character information of a selected program is displayed as it is received. In a second mode, character information in a memory is saved. In a third mode, the user may select a page of a desired program to be stored in memory.

Robinson proposes a teletext system in which a viewer can request a page over the telephone and receive that page over the air on a television set. Robinson reviews uses of teletext and mentions that programs on television could refer a viewer to a teletext page to get detail that is cut out of the television program due to time limitations.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103 a showing must be made of some objective teaching in the prior art that would lead to one of ordinary skill in the art to combine the teachings of Fukuzaki and Robinson. In the

⁹ The Office action included the Japanese language published application and brief English abstract of the application. Attached, as Exhibit 3, is an English translation of Fukuzaki.

Office action, however, there is merely the broad conclusory statement: “The examiner maintains that it would have been obvious to one of ordinary skill in the art for the TV receiver of Fukuzaki et al. to have received conventional analog TV programming of the type described in Robinson et al. and, in response to ‘content determined’ thereof, to have selected and displayed the referenced Teletext pages having a content related thereto.”¹⁰ Office action, p. 129. There is no objective teaching shown in the Office action to support this broad, conclusory statement. Accordingly, all rejections based on the combination of Fukuzaki and Robinson should be withdrawn.

a. Independent Claim 2 And Related Claims

Fukuzaki in view of Robinson fails to show or suggest the steps recited in claim 2 of determining content of a second medium, coordinating a presentation using stored information from a first medium with a presentation of a second medium, and outputting the multimedia presentation such that the presentation using the information has a predetermined relationship to content of the second medium.

Claim 2 sets forth determining content of a second medium. In the Office action, it is acknowledged that the primary reference to Fukuzaki fails to suggest this step. Office action, p. 129. It is asserted that the teaching of Robinson shows that it was well known in the art for broadcast TV programming to have included content which referred the viewer to specific program related teletext pages. Office action, p. 129. Robinson states: “News programs on television could refer a viewer to . . . pages to get the detail that is cut out due to time limitations.” Such a reference does not result in determining the content of the television program. There is no determination of the content of a television program by merely adding content to the television program that refers to a teletext page that includes related information. In other words, just because content is added does not mean that the added content is *determined*. Robinson does not suggest determining the

¹⁰ Moreover, it is not clear to applicants what is meant by this conclusion.

content of the TV program as asserted in the Office action. Robinson thus cannot be used to supplement the acknowledged deficient showing of Fukuzaki to arrive at a method step of determining content of a second medium as set forth in claim 2.

Claim 2 is amended to set forth coordinating, at the receiver station under computer control, a presentation using stored information with a presentation of the second medium based on the step of determining. In the Office action, it is asserted that Fukuzaki shows circuitry in Figure 2 for coordinating a presentation of a selected one of the stored teletext pages with the presentation of an analog TV signal based on a page selection input provided by the user. Office action, at 128. There is no suggestion in Fukuzaki that the character reception circuit shown in Figure 2 coordinates a presentation of a selected teletext page with the presentation of an analog TV signal. However, as noted in the Office action, stored teletext pages may be redisplayed based on input by the user. Thus, the user coordinates the output of the stored teletext pages. There is no suggestion of any such coordination under computer control in either Fukuzaki or Robinson.

In claim 2, the output based on the step of coordinating results in the presentation using the stored information having a predetermined relationship to the content of the second medium. There is no suggestion in Fukuzaki that the display of teletext stored in memory would have any relationship at all with any television program display. There is no suggestion in either Fukuzaki or Robinson to store teletext pages for later coordination with television programming.

For at least the above reasons, applicants respectfully request that the 35 U.S.C. §103(a) rejection of amended claim 2 as unpatentable over Fukuzaki in view of Robinson be withdrawn.

Claims 3 and 5-16 are rejected as being unpatentable over Fukuzaki in view of Robinson for the same reasons that were set forth for claim 2. These claims depend from claim 2. Applicants respectfully request the withdrawal of these rejections of claims 3

and 5-16 for at least the reasons set forth above with respect to claim 2. The following additional distinctions are noted.

Claim 9 sets forth that the step of determining causes a tuner at the receiver station to communicate audio that explains the content of the presentation using stored information to an audio output device. In the Office action, a statement in a television program referring to related teletext is relied upon to show content of a second medium that explains a significance of the presentation using stored information. Office action, p. 129. There is no step of determining suggested in the applied art that causes a tuner to communicate such a statement to an audio output device. The applied art fails to show a step of determining that causes a tuner to communicate audio to an audio output device.

Claim 11 sets forth that the plurality of signals includes a digital data channel. Claim 12 sets forth that the first medium is received in the digital data channel. The applied art does not suggest a digital data channel in a plurality of signals as set forth in these claims. There is no suggestion of coordinating the display of information received in a digital data channel with television programming.

Claim 13 sets forth that the step of determining comprises processing an identifier. Claim 14 sets forth that the identifier identifies content of the second medium. In the Office action, a statement in a television program referring to related teletext is relied upon to show a step of determining. Office action, p. 129. There is no suggestion in the applied art that an identifier is processed. There is also no suggestion that the statement would include an identifier that identifies the television program.

Claim 37 is rejected over Fukuzaki in view of Robinson for the same reasons that were set forth for claim 2. Claim 37 is an apparatus claim that is generally analogous to method claim 2. Claim 37 is amended to set forth a microcomputer that stores information from a first medium and coordinates a presentation using the information with a presentation of a received second medium based on determining content of the second medium. Fukuzaki in view of Robinson fails to show this element for the reasons

discussed above with respect to claim 2. It is acknowledged in the Office action that Fukuzaki fails to suggest determining content of the second medium. Office action, p. 129. With regard to claim 2, it is asserted that the teaching of Robinson that a statement in a television program could refer a viewer to teletext pages shows determining content. This showing is insufficient to show the limitation of claim 37, not only because the statement does not result in determining content of the television program, but also because there is no microcomputer suggested in the applied art that could determine the content of the television program based on this statement. There is also no suggestion in the applied art of a microcomputer that coordinates presentation of stored information with a second medium.

New claims 67-69 depending from claim 37 have been added. These claims are patentable over Fukuzaki in view of Robinson for at least the reasons discussed above with regard to the corresponding method claims. In addition, claim 68 sets forth that the microcomputer receives the first medium in a digital data channel. Claim 69 sets forth that the microcomputer receives the first medium in a digital data channel of a multichannel cable transmission including the second medium. Fukuzaki and Robinson fail to suggest such a digital data channel or multi-channel cable transmission.

b. Independent Claim 20 And Related Claims

Claim 20 is rejected as being unpatentable over Fukuzaki in view of Robinson for the same reasons as were set forth for claim 2. As the limitations of claim 20 were not addressed within the reasons set forth in the rejection of claim 2, the Office action fails to establish a *prima facie* case of obviousness against claim 20.

Claim 20 sets forth processing a first signal to provide a first medium and an identifier. The applied art fails to suggest processing a signal to provide a first medium and an identifier.

Claim 20 sets forth identifying content of the first medium based on the identifier. The applied art fails to suggest identifying content of a first medium based on such an identifier.

Claim 20 is amended to set forth controlling a receiver station, based on the step of identifying, to enable a coordinated presentation of the first medium and information based on a second medium, wherein the information based on the second medium is generated based on identifying content of the second medium. There is no suggestion in the applied art to control a receiver station, based on identifying a content of a first medium, to enable a coordinated presentation of the first medium and information based on a second medium generated based on identifying content of the second medium. Moreover, the claimed coordinated presentation is enabled through execution of processor instructions. This is also not suggested by Fukuzaki and Robinson.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 20 as unpatentable over Fukuzaki in view of Robinson be withdrawn.

Claims 21-23 are rejected as being unpatentable over Fukuzaki in view of Robinson for the same reasons that were set forth for claim 2. These claims depend from claim 20. Applicants respectfully request the withdrawal of these rejections of claims 21-23 for at least the reasons set forth above with respect to claim 20. In addition, claim 22 sets forth receiving the second medium in a digital data channel. Claim 23 sets forth that the plurality of signals is included in a multichannel cable transmission and includes a digital data channel including the second medium. Fukuzaki and Robinson fail to suggest such a digital data channel or multichannel cable transmission.

Added are new claims 70-73, which are apparatus claims that are generally analogous to method claims 20-23. Claims 70-73 are patentable over Fukuzaki in view of Robinson for reasons similar to those set forth above with respect to claims 20-23. Claim 70 sets forth a microcomputer for executing processor instructions to enable a

coordinated presentation of a first medium and information based on a second medium, wherein the information based on the second medium is generated based on identifying content of the second medium. Fukuzaki and Robinson fail to show such a microcomputer. Claim 72 sets forth that the microcomputer receives the second medium in a digital data channel. Claim 73 sets forth that that a plurality of signals, including the first and second medium, is included in a multichannel cable transmission that includes a digital data channel including a second medium. Fukuzaki and Robinson fail to suggest such a digital data channel or multichannel cable transmission.

c. Independent Claim 24 And Related Claims

Claim 24 is rejected as being unpatentable over Fukuzaki and Robinson for the same reasons as were set forth for claim 2. As the limitations of claim 24 were not addressed within the reasons set forth in the rejection of claim 2, the Office action fails to establish a *prima facie* case of obviousness against claim 24.

Claim 24 is amended to set forth outputting a television program at a first output device and a second medium at a second output device. Fukuzaki and Robinson fail to show or suggest outputting a second medium at a second output device. Claim 24 also is amended to include a step of comparing first information stored at a receiver station to second information corresponding to content of a television program to determine whether to present a second medium based on third information received from a source different from that of said first medium. Fukuzaki and Robinson fail to suggest such a comparison. Claim 24 is further amended to set forth a step of coordinating presentation of the television program with presentation of the second medium. Fukuzaki and Robinson fail to suggest coordinating presentation of a television program with presentation of a second medium.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 24 as unpatentable over Fukuzaki and Robinson be withdrawn.

Added is new claim 103, which depends from claim 24. Claim 103 sets forth that the television program and the third information are included in first and second channels, respectively, of a multichannel cable transmission. Fukuzaki and Robinson fail to suggest a television program and information forming the basis for a second medium included in channels of a multichannel cable transmission.

Also added are claims 74, 75, and 104, which are apparatus claims that are generally analogous to method claims 24, 25, and 103. Claims 74, 75, and 104 are patentable over Fukuzaki and Robinson for reasons similar to those set forth above with respect to claims 24, 25, and 103. Claim 74 sets forth a microcomputer for storing first information, comparing said first information to second information corresponding to content of a television program to determine whether to present a second medium based on third information received from a different source than that of a first medium including the television program, and coordinating presentation, based on the determination, of the television program with presentation of the second medium. Fukuzaki and Robinson fail to show such a microcomputer. Claim 75 sets forth that the second output device comprises a printer. Fukuzaki and Robinson suggest no printer. Claim 104 sets forth that the television program and the third information are included in first and second channels, respectively, of a multichannel cable transmission. Fukuzaki and Robinson fail to suggest a television program and information forming the basis for a second medium included in channels of a multichannel cable transmission.

d. Independent Claim 26 And Related Claims

Claim 26 is rejected as being unpatentable over Fukuzaki in view of Robinson for the same reasons as were set forth for claim 2. As the limitations of claim 26 were not

addressed within the reasons set forth in the rejection of claim 2, the Office action fails to establish a *prima facie* case of obviousness against claim 26.

Claim 26 includes the step of receiving, at a receiver station, at least two media from different sources. Neither Fukuzaki nor Robinson suggests that two media used in a multimedia presentation are received from different sources.

Claim 26 sets forth identifying content of first and second media. There is no suggestion in Fukuzaki or Robinson to identify content of two media.

Claim 26 sets forth outputting a multimedia presentation based on the step of identifying, the multimedia presentation comprising a presentation of information included in the first medium and information based on the second medium. There is no suggestion of such a multimedia presentation in Fukuzaki or Robinson.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 26 as unpatentable over Fukuzaki in view of Robinson be withdrawn.

Added are new claims 82-84, which depend from claim 26. Applicants respectfully submit that these claims are patentable over Fukuzaki in view of Robinson for at least the reasons set forth above with respect to claim 26. In addition, claim 83 sets forth that the second media is received in a digital data channel. Claim 84 sets forth that a plurality of media including the two media is included in a multichannel cable transmission including a digital data channel including the second medium. Fukuzaki in view of Robinson fails to suggest such a digital data channel or multichannel cable transmission.

Also added are claims 76-81, which are apparatus claims that are analogous in many respects to method claims 26-28, 82, and 83. Claims 76-81 are patentable over Fukuzaki and Robinson for reasons similar to those set forth above with respect to claim 26. Claim 76 sets forth a first receiver for receiving a first medium and a second receiver for receiving a second medium. Fukuzaki and Robinson fail to suggest an apparatus with

two receivers. Claim 76 also sets forth a microcomputer for identifying content of the first medium and identifying content of a second medium. Fukuzaki and Robinson fail to suggest a microcomputer that identifies content of two media. The microcomputer of claim 76 also is for controlling a multimedia presentation comprising information included in said first medium and information based on the second medium. Fukuzaki and Robinson fail to suggest a microcomputer controlling such a multimedia presentation. Claim 77 sets forth that the microcomputer controls storage of information based on the second medium. Claim 78 sets forth that the microcomputer controls storage of the first medium. Fukuzaki and Robinson fail to suggest a microcomputer controlling storage of first and second media. Claim 80 sets forth that the second receiver receives the second medium in a digital data channel. Claim 81 sets forth that a multichannel cable transmission includes the first medium and a digital data channel including a second medium. Fukuzaki and Robinson fail to suggest such a digital data channel or such a multichannel cable transmission.

e. Independent Claim 29 And Related Claims

Claim 29 is rejected as being unpatentable over Fukuzaki in view of Robinson for the same reasons as were set forth for claim 2. As the limitations of claim 29 were not addressed within the reasons set forth in the rejection of claim 2, the Office action fails to establish a *prima facie* case of obviousness against claim 29.

Claim 29 as amended includes the steps of processing a control signal at a receiver station that causes execution of processor instructions to create a series of discrete video images, causing a video image of the series of discrete images to be output, and combining the outputted video image into a multimedia presentation comprising a first medium. Fukuzaki and Robinson fail to suggest the creation of a series of discrete video images using processor instructions and thus fail to suggest these steps related to a

series of discrete video images. Fukuzaki and Robinson fail to suggest any control signal related to the creation of a series of video images.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 29 as unpatentable over Fukuzaki and Robinson be withdrawn.

Claim 30 is rejected as being unpatentable over Fukuzaki and Robinson for the same reasons that were set forth for claim 2. Claim 30 depends from claim 29. Applicants respectfully request the withdrawal of this rejection of claim 30 for at least the reasons set forth above with respect to claim 29. In addition, claim 30 sets forth that a step of identifying content of a first medium comprises processing an identifier. Fukuzaki and Robinson fail to suggest processing an identifier to identify the content of a first medium as set forth by claim 30.

Added are new claims 91-94, which depend from claim 29. Applicants respectfully submit that these claims are patentable over Fukuzaki in view of Robinson for at least the reasons set forth above with respect to claim 29. In addition, claim 93 sets forth that the second medium is received in a digital data channel. Claim 94 sets forth that a multichannel cable transmission includes the first medium including a television program and a digital data channel including the second medium. Fukuzaki and Robinson fail to suggest such a digital data channel or such a multichannel cable transmission.

Also added are claims 85-90, which are apparatus claims that are generally analogous to method claims 29, 30 and 91-94. Claims 85-90 are patentable over Fukuzaki in view of Robinson for reasons similar to those set forth above with respect to claim 29. Claim 85 sets forth a microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal, identifying content of a first medium, and then causing a video image of the series of discrete video images to be output. As discussed above, there is no suggestion in

Fukuzaki or Robinson of creating a series of discrete video images based on a control signal or executing processor instructions. Fukuzaki in view of Robinson, thus, fails to suggest a microcomputer as set forth in claim 85. Claim 86 sets forth that the microcomputer processes an identifier to identify content of the first medium. Fukuzaki and Robinson fail to suggest processing an identifier to identify a first medium as set forth in claim 86. Claim 89 sets forth that the second medium is received in a digital data channel. Claim 90 sets forth that a multichannel cable transmission includes the first medium including a television program and a digital data channel including the second medium. Fukuzaki and Robinson fail to suggest such a digital data channel or such a multichannel cable transmission.

**6. 35 U.S.C. § 103 (a) Rejection Based On
Nakazawa, Reiter, and Weinblatt**

Parts F-H of Section VIII of the Office action reject claims 2, 3, 5-6, 11-18, 26-28, 33, and 37-49 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Unexamined Patent Application Publication 62-60378 directed to the invention by Eiji Nakazawa and Akihiro Tsukamoto (Nakazawa)¹¹. Section VIII (I) of the Office action rejects claim 33 under 35 U.S.C. 103(a) as being unpatentable over Nakazawa in view of U.S. Patent 4,751,578 to Eli Reiter et al. (Reiter). Section VIII (J) rejects claims 33-36 as being unpatentable over so called “conventional audience metering devices/system” as exemplified by U.S. Patent 4,695,879 to Lee S. Weinblatt (Weinblatt) and Nakazawa. The cancellation of claims 43-49 renders the rejections of these claims moot.

Nakazawa was published March 17, 1987. Reiter issued June 14, 1988 from an application filed May 28, 1985. Weinblatt issued September 22, 1987 from an application filed February 7, 1986. The rejected claims are entitled to the benefit of the

¹¹ The Office action included the Japanese language published application and brief English abstract of the application. Attached, as Exhibit 4, is an English translation of Nakazawa.

November 3, 1981 filing date of applicants' patent application no. 317,510 for the reasons discussed above. Accordingly, Nakazawa, Reiter, and Weinblatt are not available as prior art against the rejected claims. Applicants respectfully request that these rejections be withdrawn for at least this reason. However, applicants expressly reserve the right to show how certain elements of the rejected claims are not taught or suggested by these references in the event applicants' priority claim is denied (despite the considerable evidence and case law supporting applicants' position).

Section VIII (J) of the Office action rejects claims 33-36 as being unpatentable over so called "conventional audience metering devices/system" as exemplified by Weinblatt and Nakazawa. This is not a proper rejection. *See* response to Section VII of the Office action above. As an initial matter, it is not understood what is referred to by "conventional audience metering devices/system as exemplified by Weinblatt and Nakazawa et al." as recited in the Office action. Nakazawa is not related to audience metering devices. It is unclear whether or not this rejection is simply in view of the Nakazawa and Weinblatt references. If the Examiner is referring to some greater operation or knowledge of audience metering than is described in Weinblatt, then the rejection lacks any showing that such unspecified metering teaching is prior art to the instant claims.

The Examiner takes Official notice that the need to have monitored the TV viewing habits of individuals and individual households was notoriously well known. It is not clear of what the Examiner takes Official notice. Weinblatt is directed to a television viewer meter. It is not clear what the Official notice adds that is not found in Weinblatt. Applicants respectfully traverse the Official notice to the extent that it seeks to establish anything not disclosed in Weinblatt, and request that the Examiner provide references justifying any such Official notice as required by M.P.E.P. § 2144.03.

**7. 35 U.S.C. § 103 (a) Rejection Based On
Zaboklicki and Haefner**

Parts K and L of Section VIII of the Office action rejects claims 2-16, 20-26, 29, 30, 33-40 43-46, 48, 49, and 51-60 under 35 U.S.C. § 103(a) as being unpatentable over German laid open Patent Application No. 2904981 of Edward Zaboklicki (Zaboklicki). Part M of Section VIII of the Office action rejects claims 17, 18, 27, 28, 41, 42 and 47 under 35 U.S.C. § 103(a) as being unpatentable over Zaboklicki in view of German laid open Patent Application No. 2550624 of Haefner et al. (Haefner). The cancellation of claim 43-49, and 51-60 serves to render this rejection moot with respect to these claims.

The teaching of Zaboklicki is obscure. The Examiner thus summarizes the alleged showing of Zaboklicki, in Section VII (K) (II), and then attempts to apply this broad summary against claims 24 and 25 in Section VII (K) (III). Applicants note that there are no actual citations to the text of Zaboklicki in the Examiner's broad summary and that the summary departs from the language used in either translation of Zaboklicki of record. Applicants submit that the actual unclear text of Zaboklicki, not a broad summary, must show or suggest each element of the pending claims to support these rejections under 35 U.S.C. § 103(a). That Zaboklicki fails to teach every element of the rejected claims is acknowledged in the Office action because the rejection is under Section 103. In order to support a Section 103 rejection based on a single reference, the Examiner must provide specific evidence to show why one of ordinary skill would be motivated to modify the reference in such a way to incorporate all of the claimed elements. The Office action includes no such showing. The Examiner's summary cannot substitute for such a showing in a proper rejection under 35 U.S.C. § 103. Accordingly, the Examiner's unsupported summary and its application to the pending claims is improper. In the discussion below, applicants identify the limitations that are absent from the actual Zaboklicki reference (as opposed to the summary).

Haefner is directed to a communications system that provides for interactive-type television programs to be distributed somewhat upon demand. The Haefner system uses dedicated channels to distribute requested interactive-type programming for copying at the receiver. In the Office action, it is asserted that in view of the Haefner showing, it would have been obvious to have modified the receiver station structure disclosed in Zaboklicki with local storage devices into which the entire “pool” of program segments/fragments could be downloaded and selectively retrieved under computer control.¹² Office action, p. 136. The Examiner fails to point to any objective teaching whatsoever to support his assertion that these references could be combined, as required by the controlling authorities. *See* Section II.E.1 above. Accordingly, all rejections based on this combination should be withdrawn. Moreover, the incompatibility of Zaboklicki and Haefner counsels against any such combination. Specifically, Haefner fails to suggest copying anything other than a single requested interactive-type program at one time. Haefner allows for a subscriber to be offered a variety of programs for individual selection through the option of reproduction on request at storage facilities on the subscriber side. Accordingly, the program is stored because it is individually selected. It is acknowledged in the Office action that Zaboklicki does not suggest storing selected TV and/or audio/radio programming. Zaboklicki, in direct contrast to Haefner, appears to be directed to systems that permit mass reception of interactive broadcasts. In other words, any interactive programs of Zaboklicki are transmitted to many television viewers concurrently. Modification to use storage features of the Haefner system for individual access would be entirely inconsistent with Zaboklicki’s approach. Accordingly, one of ordinary skill would not find any motivation to combine the showings of Zaboklicki and Haefner in the manner suggested in the Office action.

¹² The term “pool” is not used in either Zaboklicki or Haefner. It appears only in the Examiner’s summary and represents, in applicants’ view, merely one example of inaccurate characterizations of Zaboklicki found in the summary.

a. Independent Claim 24 And Related Claims

Claim 24 is amended to set forth outputting a television program of a multimedia presentation at a first output device and a second medium at a second output device. Zaboklicki fails to suggest a second output device at which a second medium of a multimedia presentation is output. In the Office action, it is asserted that the receivers of Zaboklicki include a printer and at least obviously a speaker (“needed to display the audio/radio output selected by element 43”). Office action, p. 135. Zaboklicki also mentions earphones (64). It is not clear whether the earphones are the speaker to which the Examiner refers. Notwithstanding, the element 43 is a circuit for adding or operating an additional audio channel of a television receiver. Accordingly, any speaker appears to output a part of a television program. Zaboklicki includes no teaching whatsoever regarding what may be output at printer 37. Claim 24 as amended sets forth a first medium including a television program and a second medium based on information received from a source different from that of the first medium. Zaboklicki includes no suggestion of a second output device at which such a second medium is output. There is no suggestion that any speaker outputs anything other than the audio channel of the television programming. There is no suggestion of what the printer may output. And regardless of whether the Examiner considers audio or an undefined printout to be the second medium, there is no teaching or suggestion in Zaboklicki of the added step of comparing first information stored at the receiver station to second information corresponding to content of the television program to determine whether to present a second medium based on third information received from a source different from that of the first medium. Zaboklicki also fails to suggest the recited combination of receiving, comparing, coordinating and outputting steps required by claim 24 as amended.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 24 as unpatentable over Zaboklicki be withdrawn.

Claim 25 depends from claim 24. Accordingly, claim 25 is patentable over Zaboklicki for at least the reasons discussed above with respect to claim 24. Claim 25 as amended sets forth that the second output device comprises a printer. As discussed above, Zaboklicki includes no suggestion that a second medium of a multimedia presentation, as claimed, is output at printer (37). Zaboklicki fails to say anything about what may be output at printer (37).

Added is new claim 103, which depends from claim 24. Claim 103 sets forth that the television program and the third information are included in first and second channels, respectively, of a multichannel cable transmission. Zaboklicki fails to suggest such a multichannel cable transmission.

Also added are claims 74, 75, and 104, which are apparatus claims that are generally analogous to method claims 24, 25, and 103. Claims 74, 75, and 104 are patentable over Zaboklicki for reasons similar to those set forth above with respect to claims 24, 25, and 103. Claim 74 sets forth a microcomputer for coordinating a television program with a presentation of a second medium, a first output device for outputting the television program, and a second output device for outputting the second medium. Zaboklicki fails to show a second output device for outputting a second medium for the reasons discussed above with respect to claim 24. Claim 75 sets forth that the second output device comprises a printer. As discussed above, Zaboklicki fails to suggest outputting the claimed second medium at the printer. Claim 104 sets forth that the television program and the third information are included in first and second channels, respectively, of a multichannel cable transmission. Zaboklicki fails to suggest such a multichannel cable transmission.

b. Independent Claim 2 And Related Claims

Claim 2 is rejected as being unpatentable over Zaboklicki for the same reasons as were set forth for claims 24 and 25. As the limitations of claim 2 were not addressed within the reasons set forth in the rejection of claim 24 and 25, the Office action fails to establish a *prima facie* case of obviousness against claim 2.

Claim 2 sets forth determining content of a second medium. Zaboklicki fails to teach or suggest a step of determining content of a second medium. For at least these reasons, applicants respectfully request that the 35 U.S.C. §103(a) rejection of amended claim 2 as unpatentable over Zaboklicki be withdrawn.

Claims 3-16 are rejected as being unpatentable over Zaboklicki for the same reasons that were set forth for claim 24-25. These claims depend from claim 2. Applicants respectfully request the withdrawal of these rejections of claims 3-16 for at least the above reasons. Claim 4 sets forth that a computer performs the step of determining. Zaboklicki suggests no such computer. Claim 6 sets forth that a plurality of signals is received from an intermediate transmitter station. Zaboklicki suggests no such intermediate transmitter station. Claim 7 as amended sets forth that the content of the second medium explains a significance of a presentation using stored information. Zaboklicki fails to suggest such a second medium. Claim 8 as amended sets forth that the content of the second medium explains the significance in audio. Zaboklicki also fails to suggest this further limitation. Claim 11 sets forth that the plurality of signals includes a digital data channel. Zaboklicki fails to suggest such a digital data channel. Claim 12 as amended sets forth that the receiver station receives the first medium in the digital data channel. Zaboklicki does not suggest receiving a first medium in a digital data channel. Claim 13 sets forth that the step of determining comprises processing an identifier. Zaboklicki fails to suggest processing any identifier to determine the content of a second medium. Claim 14 further sets forth that the identifier identifies content of the second medium. Zaboklicki fails to suggest such an identifier.

Claims 17 and 18 are rejected as being unpatentable over Zaboklicki in view of Haefner. As discussed above, Zaboklicki and Haefner are improperly combined in the Office action. Claim 17 sets forth storing the second medium at the receiver station. Haefner is directed to providing programming somewhat on demand that is then stored at a receiver. There is no suggestion that the television programming of Zaboklicki could be provided on demand and stored for the reasons set forth above. Claim 18 as amended sets forth that the first medium is received in a digital data channel of a multichannel cable transmission including a second medium. Neither Zaboklicki nor Haefner suggests such a multichannel cable transmission with first and second media used in a coordinated presentation.

Claim 37 is rejected over Zaboklicki for the same reasons that were set forth for claims 24 and 25. Claim 37 is an apparatus claim that is generally analogous to method claim 2. Claim 37 is amended to set forth a microcomputer that stores information from a first medium and coordinates a presentation using the information with a presentation of a received second medium based on determining content of the second medium. Zaboklicki fails to show such a microcomputer for the reasons discussed above with respect to claim 2. Zaboklicki fails to suggest any processor for determining content of the second medium.

Claims 38 and 39 are rejected as being unpatentable over Zaboklicki for the same reasons that were set forth for claims 24 and 25. These claims depend from claim 37. Applicants respectfully request the withdrawal of these rejections of claims 38 and 39 for at least the reasons set forth above with respect to claim 37. Claim 38 sets forth that the microcomputer determines content of the second medium by processing an identifier and sets forth a detector for detecting the identifier. Zaboklicki fails to suggest determining content based on an identifier and fails to suggest such a detector.

New claims 67-69 depending from claim 37 are added. These claims are patentable over Zaboklicki for at least the reasons discussed above with regard to claim

37. In addition, claim 68 sets forth that the microcomputer receives the first medium in a digital data channel. Claim 69 sets forth that the microcomputer receives the first medium in a digital data channel of a multichannel cable transmission including the second medium. Zaboklicki fails to suggest receiving such a digital data channel or multichannel cable transmission.

c. Independent Claim 20 And Related Claims

Claim 20 is rejected as being unpatentable over Zaboklicki for the same reasons as were set forth for claims 24 and 25. As the limitations of claim 20 were not addressed within the reasons set forth in the rejection of claims 24 and 25, the Office action fails to establish a *prima facie* case of obviousness against claim 20.

Claim 20 as amended sets forth controlling a receiver station to enable a coordinated presentation, through execution of processor instructions, of a first medium and information based on a second medium, wherein the information based on the second medium is generated based on identifying content of the second medium. Zaboklicki fails to show or suggest at least this step of controlling a receiver station as set forth in claim 20.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 20 as unpatentable over Zaboklicki be withdrawn.

Claims 21-23 are rejected as being unpatentable over Zaboklicki for the same reasons that were set forth for claims 24 and 25. These claims depend from claim 20. Applicants respectfully request the withdrawal of these rejections of claims 21-23 for at least the reasons set forth above with respect to claim 20. In addition, claim 22 sets forth receiving the second medium in a digital data channel. Claim 23 as amended sets forth that the plurality of signals is included in a multichannel cable transmission and includes

a digital data channel including the second medium. Zaboklicki fails to suggest such a digital data channel or such a multichannel cable transmission.

Added are new claims 70-73, which are apparatus claims that are generally analogous to method claims 20-23. Claims 70-73 are patentable over Zaboklicki for reasons similar to those set forth above with respect to claims 20-23. Claim 70 sets forth a microcomputer for executing processor instructions to enable a coordinated presentation of a first medium and information based on a second medium, wherein said information based on the second medium is generated based on identifying content of the second medium. Zaboklicki fails to show or suggest such a microcomputer. Claim 72 sets forth that the microcomputer receives the second medium in a digital data channel. Claim 73 sets forth that that a plurality of signals, including the first and second medium, is included in a multichannel cable transmission and includes a digital data channel including the second medium. Zaboklicki fails to show such a digital data channel or such a multichannel cable transmission.

d. Independent Claim 26 And Related Claims

Claim 26 is rejected as being unpatentable over Zaboklicki for the same reasons as were set forth for claims 24 and 25. As the limitations of claim 26 were not addressed within the reasons set forth in the rejection of claims 24 and 25, the Office action fails to establish a *prima facie* case of obviousness against claim 26.

Claim 26 as amended includes the step of receiving, at a receiver station, at least two media from different sources. Zaboklicki does not suggest receiving at least two media from different sources. Claim 26 sets forth identifying content of a first and content of a second of the at least two media. Zaboklicki does not suggest identifying the content of both first and second media. Claim 26 further sets forth outputting a multimedia presentation comprising a presentation of information included in the first

medium and information based on the second medium. Zaboklicki suggests outputting no such multimedia presentation.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 26 as unpatentable over Zaboklicki be withdrawn.

Claims 27 and 28 are rejected as being unpatentable over Zaboklicki in view of Haefner. As discussed above, Zaboklicki and Haefner are improperly combined in the Office action. Claim 27 sets forth storing the information based on the second medium at the receiver station. Haefner is directed to providing programming somewhat on demand that is then stored at a receiver. Zaboklicki and Haefner fail to suggest storing information based on a second medium as set forth by amended claim 27. Claim 28 as amended sets forth storing the first medium at the receiver station. There is no suggestion that the television programming of Zaboklicki could be provided on demand and stored for the reasons set forth above.

Added are new claims 82-84, which depend from claim 26. Applicants respectfully submit that these claims are patentable over Zaboklicki for at least the reasons set forth above with respect to claim 26. In addition, claim 83 sets forth that the second medium is received in a digital data channel. Claim 84 sets forth that a plurality of media including the two media is included in a multichannel cable transmission including a digital data channel including the second medium. Zaboklicki fails to suggest such a digital data channel or such a multichannel cable transmission.

Also added are claims 76-81, which are apparatus claims that are analogous in many respects to method claims 26-28, 82, and 83. Claims 76-81 are patentable over Zaboklicki for at least reasons similar to those set forth above with respect to claim 26. Claim 76 sets forth a microcomputer for identifying content of the first medium and identifying content of the second medium and controlling, based on identifying the content, a multimedia presentation comprising information included in the first medium

and information based on the second medium. Zaboklicki fails to suggest such a microcomputer. Claim 77 sets forth that the microcomputer controls storage of information based on the second medium. Claim 78 sets forth that the microcomputer controls storage of the first medium. Zaboklicki and Haefner fail to suggest a microcomputer controlling storage as set forth in claims 77 and 78. Claim 80 sets forth that a second receiver receives the second medium in a digital data channel. Claim 81 sets forth that a multichannel cable transmission includes the first medium and a digital data channel including a second medium. Zaboklicki fails to suggest such a digital data channel or such a multichannel cable transmission.

e. Independent Claim 29 And Related Claims

Claim 29 is rejected as being unpatentable over Zaboklicki for the same reasons as were set forth for claims 24 and 25. As the limitations of claim 29 were not addressed within the reasons set forth in the rejection of claims 24 and 25, the Office action fails to establish a *prima facie* case of obviousness against claim 29.

Claim 29 as amended includes the steps of processing a control signal at a receiver station that causes execution of processor instructions to create a series of discrete video images, causing a video image of the series of discrete images to be output, and combining the outputted video image into a multimedia presentation comprising a first medium. Zaboklicki fails to suggest any series of discrete video images and thus fails to suggest these steps related to a series of discrete video images. Zaboklicki fails to suggest any control signal related to the creation of a series of video images.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 29 as unpatentable over Zaboklicki be withdrawn.

Claim 30 is rejected as being unpatentable over Zaboklicki for the same reasons that were set forth for claim 24 and 25. Claim 30 depends from claim 29. Applicants

respectfully request the withdrawal of this rejection of claim 30 for at least the reasons set forth above with respect to claim 29.

Added are new claims 91-94, which depend from claim 29. Applicants respectfully submit that these claims are patentable over Zaboklicki for at least the reasons set forth above with respect to claim 29. In addition, claim 93 sets forth that the second medium is received in a digital data channel. Claim 94 sets forth that a multichannel cable transmission includes the first medium including a television program and a digital data channel including the second medium. Zaboklicki fails to suggest such a digital data channel and such a multichannel cable transmission.

Also added are claims 85-90, which are apparatus claims that are generally analogous to method claims 29, 30 and 91-94. Claims 85-90 are patentable over Zaboklicki for reasons similar to those set forth above with respect to claim 29. Claim 85 sets forth a microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal, identifying content of a first medium, and then causing a video image of the series of discrete video images to be output. As discussed above, there is no suggestion in Zaboklicki of creating a series of discrete video images based on a control signal. Zaboklicki, thus, fails to suggest a microcomputer as set forth in claim 85. Claim 89 sets forth that the second medium is received in a digital data channel. Claim 90 sets forth that a multichannel cable transmission includes the first medium including a television program and a digital data channel including the second medium. Zaboklicki fails to suggest such digital data channel or such a multichannel cable transmission.

f. Independent Claim 33 And Related Claims

Claim 33 is rejected as being unpatentable over Zaboklicki for the same reasons as were set forth for claims 24 and 25. As the limitations of claim 33 were not addressed

within the reasons set forth in the rejection of claims 24 and 25, the Office action fails to establish a *prima facie* case of obviousness against claim 33.

Claim 33 as amended includes the step of receiving a user response based on a step of outputting a first signal, comparing the user response to information corresponding to content of the first signal, and tuning the receiver station to receive a second signal based on the step of comparing. Zaboklicki does not include sufficient details to suggest comparing a user response to information corresponding to content of a first signal. Zaboklicki also fails to include any showing or suggestion of tuning the receiver station to receive a second signal based on the step of comparing.

Applicants respectfully request that for at least the above reasons the 35 U.S.C. §103(a) rejection of amended independent claim 33 as unpatentable over Zaboklicki be withdrawn.

Claims 34-36 are rejected as being unpatentable over Zaboklicki for the same reasons that were set forth for claims 24 and 25. Claims 34-36 depend from claim 33. Applicants respectfully request the withdrawal of these rejections of claims 34-36 for at least the reasons set forth above with respect to claim 30. In addition, claim 35 as amended sets forth that information included in the second signal is output to a printer. Zaboklicki fails to suggest such output at a printer.

Added are new claims 101-102, which depend from claim 33. Applicants respectfully submit that these claims are patentable over Zaboklicki for at least the reasons set forth above with respect to claim 33. In addition, claim 102 sets forth that the first and second signals are received in a multichannel cable transmission. Zaboklicki fails to suggest such a multichannel cable transmission.

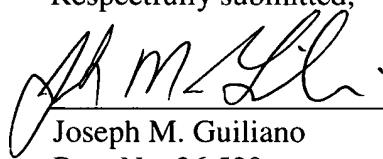
Also added are claims 95-100, which are apparatus claims that are generally analogous to method claims 33-36, 101, and 102. Claims 95-100 are patentable over Zaboklicki for at least reasons similar to those set forth above with respect to claim 33. Claim 95 sets forth a microcomputer for receiving a user response based on outputting a

first signal, comparing the user response to information corresponding to content of the first signal, and based on the comparison tuning the second receiver to receive a second signal. Zaboklicki fails suggest such a microcomputer. Claim 77 sets forth that the microcomputer controls storage of information based on the second medium. Claim 100 sets forth that the first and second signals are received in a multichannel cable transmission. Zaboklicki fails to suggest such a multichannel cable transmission.

III. CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Reconsideration and allowance of the instant application are respectfully requested.

Date: January 29, 2003
FISH & NEAVE
1251 Avenue of the Americas
New York, New York 10020

Respectfully submitted,

Joseph M. Guiliano
Reg. No. 36,539
Phone No. 212-596-9081